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IN THE

Supreme Court of the United States

OCTOBER TERM, 2002

DESERET BOOK COMPANY; DEAN HUGHES,

Petitioners,

v.

GENE S. JACOBSEN,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Tenth Circuit

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PETITION FOR WRIT OF CERTIORARI

KENNETH W. STARR
KANNON K. SHANMUGAM
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, DC 20005
(202) 879-5000

MARY ANNE Q. WOOD
Counsel of Record
KATHRYN O. BALMFORTH
WOOD CRAPO LLC
500 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
(801) 366-6060

[*additional counsel on inside cover*]

September 23, 2002

67 pp

RICHARD G. WILKINS*
J. Reuben Clark Law School
513 J. Reuben Clark Building
Brigham Young University
Provo, UT 84602
(801) 422-2669

KENT B LINEBAUGH
JONES, WALDO, HOLBROOK
& MCDONOUGH
170 South Main Street
Salt Lake City, UT 84101
(801) 521-3200

* *affiliation given for associational purposes only*

QUESTION PRESENTED

Whether, for purposes of copyright infringement, a subsequent work is sufficiently "similar" to a copyrighted historical work where the appropriation of expressive elements, if any, is minimal.

STATEMENT PURSUANT TO RULE 29.6

Petitioner Deseret Book Company, Inc., is wholly owned by Deseret Management Corporation, which is the holding company for the commercial enterprises of The Church of Jesus Christ of Latter-day Saints.

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

STATEMENT PURSUANT TO RULE 29.6 ii

TABLE OF AUTHORITIES v

INTRODUCTION 1

OPINIONS BELOW 3

JURISDICTION 3

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS 4

STATEMENT OF THE CASE 5

A. Factual Background 5

B. The District Court Proceedings 6

C. The Court Of Appeals Proceedings 7

REASON FOR GRANTING THE WRIT 9

THE COURT OF APPEALS ERRED BY HOLDING THAT A SUBSEQUENT WORK IS SUFFICIENTLY "SIMILAR" TO A COPYRIGHTED HISTORICAL WORK WHERE THE APPROPRIATION OF EXPRESSIVE ELEMENTS, IF ANY, IS MINIMAL ... 9

A. The Decision Below Is In Tension With Prior Decisions Of This Court 9

B. The Decision Below Conflicts With Decisions Of The Ninth And Other Circuits 13

C. The Question Presented Is A Recurring One Of Exceptional Importance 16

CONCLUSION 18

TABLE OF AUTHORITIES

Page

Cases

Arica Institute, Inc. v. Palmer,
970 F.2d 1067 (2d Cir. 1992) 13

Baker v. Selden,
101 U.S. 99 (1880) 3

Campbell v. Acuff-Rose Music, Inc.,
510 U.S. 569 (1994) 13

Feist Publications, Inc. v. Rural Telephone Service Co.,
499 U.S. 340 (1991) ..... *passim*

Harper & Row, Publishers, Inc. v. Nation Enterprises,
471 U.S. 539 (1985) ..... *passim*

Hoehling v. Universal City Studios, Inc.,
618 F.2d 972 (2d Cir.),
cert. denied, 449 U.S. 841 (1980) ..... *passim*

Mills Music, Inc. v. Snyder,
469 U.S. 153 (1985) 13

Narell v. Freeman,
872 F.2d 907 (9th Cir. 1989) ..... *passim*

Nash v. CBS, Inc.,
899 F.2d 1537 (7th Cir. 1990) 2, 13, 16, 17

New York Times Co. v. Tasini,
533 U.S. 483 (2001) 2, 13

Rokeach v. Avco Embassy Pictures Corp.,
197 U.S.P.Q. 155 (S.D.N.Y. 1978) 11

Rosemont Enterprises, Inc. v. Random House, Inc.,
366 F.2d 303 (2d Cir. 1966),
cert. denied, 385 U.S. 1009 (1967) 2, 15

Russell v. Turnbaugh,
18 U.S.P.Q.2d 1948 (D. Colo. 1991) 3, 11

Sony Corp. of America v. Universal City Studios, Inc.,
464 U.S. 417 (1984) 13

Suid v. Newsweek Magazine,
503 F. Supp. 146, 148 (D.D.C. 1980) 11

Constitutions, Statutes, and Rules

17 U.S.C. § 102 ..... 1, 4, 9, 17

28 U.S.C. § 1254 3

S. Ct. R. 10 9

Secondary Materials

Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information, 90 Colum. L. Rev. 1865 (1990) 12

M. Nimmer & D. Nimmer, Copyright (2000) 13

INTRODUCTION

In two pathmarking decisions, this Court has provided lower courts much-needed guidance on important and recurring issues of copyright law. In *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), the Court set out the factors to be taken into account in determining whether copying of otherwise protected material constitutes "fair use." *See id.* at 560-69. Six years later, in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), the Court held that a compilation containing only factual material was not entitled to copyright protection where the factual material was not selected, coordinated or arranged in an original manner. *See id.* at 361-64.

Now, a decade later, this case presents another issue that richly warrants this Court's attention. At stake is a fundamental and sensitive question in our system of free expression—the use of facts and ideas. As the Court noted in *Harper & Row*, "[e]specially in the realm of factual narrative, the law is currently unsettled regarding the ways in which uncopyrightable elements combine with the author's original contributions to form protected expression." 471 U.S. at 548. The difficulty arises because facts and ideas are not entitled to copyright protection, *see* 17 U.S.C. § 102(b), whereas "expressive" aspects of an author's work do enjoy such protection, *see Harper & Row*, 471 U.S. at 547. Necessarily, therefore, "the fact/expression dichotomy limits severely the scope of protection in fact-based works." *Feist*, 499 U.S. at 350. This Court has not had occasion to speak, however, on the pivotal task of how courts should go about determining what elements in a copyrighted work are protectible, nor determining whether a copyrighted, fact-based work is sufficiently similar to an allegedly copying work for infringement to have occurred. It is in this day-to-day world of burgeoning copyright litigation that this Court's guidance is necessary.

This case squarely presents these closely related questions. The Tenth Circuit allowed a claim of copyright infringement to proceed against petitioners, an author (prominent novelist Dean Hughes) and

publisher (Deseret Book Company), for incorporating factual anecdotes from a copyrighted autobiographical memoir into a fictional work. The court did so despite the fact that it did not find that petitioners copied any of the exact words of the copyrighted work, save for a single brief passage (which itself was not even reproduced verbatim). That passage consists only of a 44-word quotation from a third party, which the copyrighted work itself merely reported. *See* App. 12a-13a.

The Tenth Circuit's decision is in conflict with the decisions of other circuits, which have allowed minimal verbatim copying of language when an author is copying facts from a historical, factual work. Most notably, in *Narell v. Freeman*, 872 F.2d 907 (1989), the Ninth Circuit expressly permitted the copying of occasional phrases from a historical work. Other circuits have reached similar conclusions. *See Nash v. CBS, Inc.*, 899 F.2d 1537 (7th Cir. 1990); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 974 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980); *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

Certiorari is warranted for two additional reasons. *First*, uniformity among the circuits is particularly important in an area of the law such as copyright, in which the decision of one circuit can effectively force a publisher to alter its practices nationwide. In light of this reality, the Court has granted *certiorari* on important issues of copyright law even when there is no split in the circuits. *See, e.g., New York Times Co. v. Tasini*, 533 U.S. 483 (2001). Indeed, there was no split in either *Harper & Row* or *Feist*.

Second, the Tenth Circuit's decision will have significant practical implications, not only for novelists such as petitioner Hughes and publishers such as petitioner Deseret Book, but also for historians, moviemakers, and the broadcast media, who frequently produce works based on previously reported factual incidents. *See, e.g., Nash*, 899 F.2d at 1538-39 (episode of

television series based on historical book); *Hoehling*, 618 F.2d at 975-76 (movie based on historical book). It will also have implications for the news media, who routinely repackage news stories taken from other sources. *See, e.g., Russell v. Turnbaugh*, 18 U.S.P.Q.2d 1948, 1951-52 (D. Colo. 1991) (newspaper stories closely paraphrased from other newspaper stories).

More than a century ago, this Court observed: "The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book." *Baker v. Selden*, 101 U.S. 99, 103 (1880). Under the Tenth Circuit's decision, authors can now be held liable for copyright infringement if the factual details of their work too closely resemble the factual details of a previous work—even if the facts are retold almost entirely in the authors' own words. Because the Tenth Circuit's decision promises to have substantial chilling effects on our system of free expression, *certiorari* should be granted.

OPINIONS BELOW

The Tenth Circuit's opinion is reported at 287 F.3d 936 and reprinted in the Appendix ("App.") at 1a-27a. The unreported order denying the petition for rehearing *en banc* is reprinted at App. 28a-29a. The district court's unpublished order granting the motion to dismiss is reprinted at App. 30a-39a.

JURISDICTION

The Tenth Circuit entered judgment on April 19, 2002. Petitioners timely filed a petition for rehearing *en banc*, which was denied on June 24, 2002. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS

Section 102 of the Copyright Act, 17 U.S.C. § 102, states as follows:

> (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:
>
> (1) literary works;
>
> (2) musical works, including any accompanying words;
>
> (3) dramatic works, including any accompanying music;
>
> (4) pantomimes and choreographic works;
>
> (5) pictorial, graphic, and sculptural works;
>
> (6) motion pictures and other audiovisual works;
>
> (7) sound recordings; and
>
> (8) architectural works.
>
> (b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

STATEMENT OF THE CASE

A. Factual Background

Respondent Gene S. Jacobsen was a prisoner of war in the Philippines and Japan during World War II. *See* App. 1a. After returning from the war, Jacobsen wrote a personal memoir entitled *Who Refused to Die*. *See id.* That memoir is a personal account of Jacobsen's experiences in the Bataan Death March and as a prisoner of war. *See id.* at 31a. Jacobsen has testified that the memoir is entirely factual. *See* C.A. Appellants' App. 10, 12, 264, 316, 809; C.A. Appellees' Supp. App. 36. Jacobsen was unable to get his memoir published, *see* App. 32a, and instead distributed unpublished copies of the manuscript informally to family and friends, *see id.* at 31a.

Petitioner Dean Hughes authored, and Petitioner Deseret Book Company published, a five-volume fictional series entitled *Children of the Promise*. *See id.* at 2a. The series was written primarily for members of The Church of Jesus Christ of Latter-day Saints. *See id.* It tells the story of a fictional Latter-day Saints family's life during World War II. *See id.*

Hughes originally entered into an agreement with Deseret Book in 1994 to produce *Children of the Promise*. *See id.* at 31a. Hughes was given a copy of Jacobsen's memoir by Jacobsen's son, who worked with Hughes' wife. *See id.* Upon reading the memoir, Hughes decided that Jacobsen's story would make a good plot line for *Children of the Promise*. *See id.* To that end, he met with Jacobsen on multiple occasions to discuss his experiences. *See id.* at 37a. Hughes based the story of Wally Thomas, one of the fictional family's sons, closely on Jacobsen's real-life story. *See id.* at 2a.

In 1996, Hughes sent Jacobsen excerpts from the first volume of the series, together with a letter stating, "I don't want to do anything you wouldn't feel good about, so let me know if anything is either wrong or somehow troubles you." *Id.* at 37a. Jacobsen

responded with a letter stating that he had read the material and looked forward to the finished product. *See id.* Hughes formally dedicated the second volume of the series to Jacobsen. *See id.* at 32a.

Children of the Promise enjoyed significant commercial success. In 1999, after four volumes of the series had been published, Jacobsen brought suit, claiming copyright infringement. *See id.* Jacobsen only registered his copyright once he had already brought suit. *See id.* at 31a.

B. The District Court Proceedings

After a year of litigation, petitioners moved to dismiss on the pleadings, on the ground that Jacobsen's complaint alleged that Hughes copied only "events, sequences of events, and characters," rather than protected expression. *Id.* at 33a. After carefully reviewing the works at issue, the district court dismissed the complaint. *See id.* at 30a-39a.[1]

The district court noted that Hughes did not copy "precise words" used by Jacobsen, but rather, at most, occasionally used "individual phrases" found in Jacobsen's manuscript, which, the court concluded, were "not original nor distinctive." *Id.* at 34a. The court reasoned that "it is clear that Mr. Hughes copied some 'facts' from Mr. Jacobsen's memoir, but not significant original expression." *Id.* at 36a. The court expressly compared this case to the Ninth Circuit's decision in *Narell v. Freeman*, and concluded that here, as in *Narell*, the allegedly infringing author appropriated only historical research, not significant original expression. *See id.*

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[1] In the alternative, the district court granted summary judgment on the affirmative defense of laches. *See id.* at 37a-38a.

C. The Court Of Appeals Proceedings

The Tenth Circuit reversed. *See id.* at 1a-27a. The court acknowledged that "[t]he difficulty in this case arises in determining whether Dr. Hughes copied only unprotected facts or instead impermissibly copied Dr. Jacobsen's original expression." *Id.* at 5a. Citing Nimmer's treatise on copyright law, the court conceded that the measure of how substantially similar the two works must be for infringement to occur varies according to the circumstances, with more similarity required when less protectible subject matter is at issue. *See id.* at 7a.

With those background principles, the Tenth Circuit then engaged in its own comparison of the Jacobsen and Hughes works. *See id.* at 10a-16a. The court asserted that Hughes copied "much of the plot line for Wally Thomas" from Jacobsen's memoir. *Id.* at 10a. After cataloging several anecdotes that appear in both works, the court asserted that "[i]n some instances, the copying goes beyond close paraphrasing and reproduces Dr. Jacobsen's words exactly." *Id.* at 12a.

Despite its statement that there were "some instances" of verbatim copying, however, the Tenth Circuit cited only one, involving Jacobsen's description of his journey to unite with American troops after the war ended. *See id.* at 12a-13a. The court quoted the relevant passage from Hughes' work, italicizing words that are identical in the two works:

> This time it was Potts who walked on ahead. He was carrying a souvenir sword of his own. When he stepped onto the deck, he shouted, "We need to talk," and he slammed his sword into the deck, sticking it up by its point. * * * "*Listen* to me *you guys*," Potts went on. "*General* Douglas *MacArthur* has authorized us *to use any means* we find *necessary* to reach American troops. *We*'re *going to* cross *this bay with you or without you. If you want to take us*

> *across and get paid for your troubles, fine. If you don't, get off the ship, and we'll take* her across ourselves."

Id. at 13a.

The Tenth Circuit then rejected the district court's comparison of this case to *Narell*. It reasoned that *Narell* "involved verbatim copying of only a few words and phrases," whereas in this case, "the above cited example * * * reveals Dr. Hughes and Deseret Book *arguably* copied more than a few words and phrases." *Id.* at 13a-14a (emphasis added). The court also rejected the argument that the quoted language was not even protectible. *See id.* at 14a. It hypothesized that "Dr. Jacobsen may have enclosed the material in quotations merely to allow him to speak in the voice of a third party while recording his story," and therefore that the quoted language may have constituted original expression rather than fact. *Id.* The court added that, because Hughes' work contained enough material for a trier of fact to find verbatim copying, it was not necessary to address whether any paraphrasing by Hughes, absent verbatim copying, could give rise to a copyright violation. *See id.* at 15a.[2]

The Tenth Circuit denied rehearing *en banc*. *See id.* at 28a-29a. On remand, the district court stayed proceedings pending the filing of this petition.

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[2] The Tenth Circuit also reversed the district court's decision to grant summary judgment on the affirmative defense of laches, and reversed an evidentiary ruling. *See id.* at 16a-27a.

REASON FOR GRANTING THE WRIT

THE COURT OF APPEALS ERRED BY HOLDING THAT A SUBSEQUENT WORK IS SUFFICIENTLY "SIMILAR" TO A COPYRIGHTED HISTORICAL WORK WHERE THE APPROPRIATION OF EXPRESSIVE ELEMENTS, IF ANY, IS MINIMAL.

This Court should grant *certiorari* because the decision below is in tension with this Court's prior decisions in *Harper & Row* and *Feist* and conflicts with decisions of other courts of appeals, and because the petition presents a recurring question of exceptional importance. *See* S. Ct. R. 10.

A. The Decision Below Is In Tension With Prior Decisions Of This Court.

The Tenth Circuit's decision is inconsistent with the general framework set out by this Court in *Harper & Row* and *Feist* for assessing the similarity of copyrighted and allegedly infringing works.

In *Harper & Row*, the political magazine The Nation published an article drawing heavily from the unpublished memoirs of President Ford. For purposes of its analysis, the Court summarily concluded that the memoirs were copyrighted and that The Nation copied sufficient protected material to otherwise give rise to copyright infringement. *See Harper & Row*, 471 U.S. at 548-49. The Court therefore devoted most of its opinion to the question whether the use of quotations from the unpublished manuscript of a public figure constituted "fair use" under the relevant provision of the Copyright Revision Act of 1976. *See id.* at 549-69.

Before turning to that question, however, the Court did briefly lay out the underlying principles for determining whether a work contains copyrightable material in the first place. Writing for the Court, Justice O'Connor first recognized that § 102 of the Copyright Act, 17 U.S.C. § 102, bars any author from copyrighting

facts or ideas, *see Harper & Row*, 471 U.S. at 547. Instead, the Court noted, "[t]he copyright is limited to those aspects of the work—termed 'expression'—that display the stamp of the author's originality." *Id.* Although the Court recognized that "[c]reation of a nonfiction work, even a compilation of pure fact, entails originality," it quickly added that "copyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original * * * as long as such use does not unfairly appropriate the author's original contributions." *Id.* at 548. And notably, the Court acknowledged that, "[e]specially in the realm of factual narrative, the law is currently unsettled regarding the ways in which uncopyrightable elements combine with the author's original contributions to form protected expression." *Id.*

Justice Brennan dissented. Unlike the majority, Justice Brennan addressed at length the threshold question of copyrightability. *See Harper & Row*, 471 U.S. at 580-87 (dissenting opinion). Crucially, the majority did not take issue with Justice Brennan's analysis in this respect. Justice Brennan ultimately concluded that, although the verbatim copying at issue constituted copyright infringement, the paraphrasing did not. *See id.* at 587.

Like the Court, Justice Brennan began by recognizing that facts and ideas could not be copyrighted—and added that such a rule was required to protect First Amendment values. *See id.* at 582. As a result, therefore, "infringement of copyright must be based on a taking of literary form, as opposed to the ideas or information contained in a copyrighted work." *Id.*

Justice Brennan then proceeded to compare the language and structure of the two works in order to determine whether they were substantially similar. As to language, he reasoned that mere "linguistic similarities" between the two works, without more, were insufficient to constitute infringement. *Id.* at 585. He based that conclusion on the fact that much of what The Nation paraphrased

was quoted material, and "[n]o copyright can be asserted in the verbatim representation of [the] statements of others." *Id.* at 586 n.10.[3] But he also noted that "[a]t most The Nation paraphrased disparate isolated sentences from the original," and that such disparate paraphrasing was insufficient to give rise to infringement. *Id.* at 586. As to structure, Justice Brennan reasoned that, to the extent that The Nation's article tracked the order of events recounted in the Ford memoir, an author who presents historical facts chronologically cannot claim infringement when a subsequent author does so as well, even if the subsequent author includes only those facts that the first author selected for presentation. *See id.* at 586-87 & n.12.

In *Feist*, the Court considered whether a white pages telephone directory was entitled to copyright protection, and held that it was not. Again writing for the Court, Justice O'Connor began, as in *Harper & Row*, by emphasizing that "facts are not copyrightable." *See Feist*, 499 U.S. at 344. The Court recognized that factual *compilations* could be copyrighted, but only to the extent that they have original components. *See id.* at 348-49. The Court reasoned that, absent the addition of original *expression* to the underlying facts, a factual compilation such as a directory could be protected only to the extent that the facts are selected, coordinated or arranged in an original manner. *See id.* Notably, the Court appeared to suggest that, in the context of a factual work, only verbatim copying of original expression could give rise to copyright infringement. *See id.* at 348 ("Others may copy the underlying facts from the publication, but not the precise words used to present them.").

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[3] Lower courts have uniformly concluded that a quoting author may not assert copyright over material quoted from others. *See, e.g., Russell v. Turnbaugh*, 18 U.S.P.Q.2d 1948, 1951 (D. Colo. 1991); *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 148 (D.D.C. 1980); *Rokeach v. Avco Embassy Pictures Corp.*, 197 U.S.P.Q. 155, 161 (S.D.N.Y. 1978).

The Court freely acknowledged that "[t]his inevitably means that the copyright in a factual compilation is thin." *See id.* at 349. Quoting Professor Ginsburg's influential article on the scope of copyright protection, the Court reasoned that, "[n]o matter how much original authorship the work displays, the facts and ideas it exposes are free for the taking." *Id.* (quoting Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information, 90 Colum. L. Rev. 1865, 1868 (1990)). The Court asserted that the so-called "fact/expression dichotomy" was "neither unfair nor unfortunate," even though it "limits severely the scope of protection in fact-based works." *Id.* at 350. Applying these principles, the Court ultimately concluded that the white pages at issue were not entitled to copyright protection because they lacked any original components. *See id.* at 364.

Remarkably, notwithstanding this Court's decisions in *Harper & Row* and *Feist*, the Tenth Circuit made no threshold effort to identify which components of Jacobsen's memoir constituted unprotected fact, and which constituted protected expression. Indeed, the court explicitly refused to "abstract" the unprotected ideas from the protected expression. *See* App. 6a n.5. Instead, the court simply searched the two works for examples of verbatim copying, with scant regard for whether the relevant passage in the copyrighted work contained original expression. And as to the single passage as to which verbatim copying was identified, the Tenth Circuit stated only that the passage *might* contain original expression, on the hypothesis that "Dr. Jacobsen may have enclosed the material in quotations merely to allow him to speak in the voice of a third party while recording his story." App. 14a. That hypothesis, however, was plainly belied by Jacobsen's repeated assertions that the memoir is entirely factual. *See* C.A.

Appellants' App. 10, 12, 264, 316, 809; C.A. Appellees' Supp. App. 36.[4]

In sum, the Tenth Circuit's failure to identify any protected passages in Jacobsen's memoir is inconsistent with the analytical framework of *Harper & Row* and *Feist*. At a minimum, the Court should grant *certiorari* to resolve the uncertainty it identified in *Harper & Row* regarding the application of this analytic framework in the area of historical, factual works.

B. The Decision Below Conflicts With Decisions Of The Ninth And Other Circuits.

As a threshold matter, it is worth again noting that this Court has frequently granted *certiorari* on important issues of copyright law even where there is no direct circuit conflict. *See, e.g., Tasini*, 533 U.S. at 483; *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994); *Feist*, 499 U.S. at 340; *Harper & Row*, 471 U.S. at 539; *Mills Music, Inc. v. Snyder*, 469 U.S. 153 (1985); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

Here, however, there is a direct conflict, and this Court's review is thus all the more urgent. Specifically, by allowing a copyright-infringement claim involving a historical, factual work to proceed where the appropriation of expressive elements (if any) is incidental, the Tenth Circuit put itself squarely into conflict with the Ninth Circuit's decision in *Narell*, and also into conflict with decisions from the Second and Seventh Circuits.

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[4] In so hypothesizing, the Tenth Circuit unwittingly abrogated the doctrine of copyright estoppel, under which "one who represents his work to be completely factual may not in a subsequent infringement action prove that part of the work was fictional and therefore protectible." 1 M. Nimmer & D. Nimmer, Copyright § 2.11[C], at 2-172.20 to 2.172.21 (2000). To the extent that the Tenth Circuit's decision can be read to repudiate the doctrine of copyright estoppel, it is in tension with the decisions of at least two other circuits. *See Arica Institute, Inc. v. Palmer*, 970 F.2d 1067, 1075 (2d Cir. 1992); *Nash v. CBS, Inc.*, 899 F.2d 1537, 1540 (7th Cir. 1990).

In *Narell*, the Ninth Circuit considered a strikingly similar claim that a fictional work about the heir of a wealthy Jewish family infringed on a historical book on the activities of Jewish families in California. *See* 872 F.2d at 909. The Ninth Circuit affirmed the district court's decision to grant summary judgment to the defendants. *See id.* at 915. Specifically, the court concluded that the allegedly infringing author, Cynthia Freeman, copied no protected expression from the copyrighted work. *See id.* at 912.

The court began by noting that "[h]istorical facts and theories may be quoted, as long as the defendant does not bodily appropriate the expression of the plaintiff." *Id.* at 910-11 (internal quotation omitted). The court conceded that Freeman copied a number of phrases from the copyrighted work, including "rekindle old memories," "staggering network," "river wound its way between muddy banks crawling with alligators," and "hordes of gold seekers." *Id.* at 911. The court reasoned, however, that most of these phrases were commonly used expressions. *See id.* And the court further noted that, to the extent that Freeman paraphrased other elements of the copyrighted work, those elements were mere factual details and therefore not protected either.

By way of an example, the Ninth Circuit cited Longfellow's poem about the ride of Paul Revere. *See id.* at 912. The court noted that "direct copying" of some or all of the famous opening stanza could constitute infringement, assuming that the original held a valid copyright registration. *Id.* The court, however, distinguished copying of "the equivalent of a unique line or stanza" from merely "duplicat[ing] a few ordinary phrases and paraphras[ing] largely factual statements in creating a different kind of story." *Id.* Because Freeman did only the latter, the Ninth Circuit reasoned that "[a] reasonable juror could not conclude that Freeman copied protected expression" from the copyrighted work. *Id.*

The present case is indistinguishable from *Narell*. Here, Hughes at most copied isolated phrases from Jacobsen's work: indeed, in

the single example cited by the Tenth Circuit, Hughes did not copy the entire quotation, but instead only copied such commonplace phrases as "use any means," "get paid for your troubles," and "get off the ship." App. 13a. The Tenth Circuit's attempt to distinguish *Narell* by asserting that "the above cited example * * * reveals Dr. Hughes and Deseret Book *arguably* copied more than a few words and phrases," *id.* at 14a (emphasis added), is therefore entirely unpersuasive. The Tenth Circuit's decision is in direct conflict with *Narell*.

The Tenth Circuit's decision is also in conflict with the decisions of the Second and Seventh Circuits, which took similar methodological approaches to the Ninth Circuit. In *Rosemont Enterprises*, the Second Circuit considered whether a biography of Howard Hughes infringed on copyrighted magazine articles on the same subject. The court recognized that the book copied two direct quotations and one eight-line paraphrase from the articles. *See* 366 F.2d at 306. The court reasoned, however, that there was considerable doubt as to whether the quoted and paraphrased material constituted a substantial part either of the articles or of the biography. *See id.* The court therefore concluded that, although the biography relied heavily on the articles, there was insufficient evidence of infringement to warrant the entry of a preliminary injunction. *See id.*

In *Hoehling*, the Second Circuit affirmed the entry of summary judgment for Universal Studios and an author on a claim that their book and movie about the Hindenberg infringed on a previous book about the same. *See* 618 F.2d at 979-80. The court began by noting that, "absent wholesale usurpation of another's expression, claims of copyright infringement where works of history are at issue are rarely successful." *Id.* at 974. The court added that "the scope of copyright in historical accounts is narrow indeed, embracing no more than the author's original expression of particular facts and theories already in the public domain." *Id.* Accordingly, the court rejected the copyright holder's claim that his copyright was infringed

because the allegedly infringing works copied the basic plot of his book, specific facts, and (most notably for purposes of this case) "random duplications of phrases and sequences of events." *Id.* at 979.

Finally, in *Nash*, the Seventh Circuit similarly affirmed a grant of summary judgment to CBS and other defendants in a case involving a television program that allegedly infringed on four historical books written by the same author, Jay Robert Nash, in which he laid out his own unique theory about the fate of the gangster John Dillinger. *See* 899 F.2d at 1539. Judge Easterbrook, writing for the court, reasoned that, "[i]f Nash had written a novel that another had translated into a screenplay, this would be a difficult case." *Id.* at 1541. The fact, however, that "Nash does not portray [his books] as fiction * * * makes all the difference." *Id.* The court noted that the television producers used the books merely "as a source of facts and ideas, to which they added their distinctive overlay." *Id.* at 1543. Although *Nash* involved the alleged appropriation only of a plot line, its broad reasoning is equally applicable to incidental appropriation of expressive elements as well.

All of these cases establish that an author is permitted to engage in incidental appropriation of expressive elements from a historical, factual work. Because the Tenth Circuit's decision is contrary to the overwhelming weight of authority, and especially in view of this Court's demonstrated willingness to ensure uniformity on important questions of copyright law, *certiorari* is warranted.

C. The Question Presented Is A Recurring One Of Exceptional Importance.

The Tenth Circuit's outlying decision will have enormous practical implications. As the cases discussed above reflect, facts from copyrighted historical works are used in a variety of contexts—from novels to subsequent historical works, from movies to documentaries. It is inevitable that, in taking facts from copyrighted historical works, authors will copy incidental words or

phrases as well. *See, e.g.*, *Harper & Row*, 471 U.S. at 585-86 (Brennan, J., dissenting); *Narell*, 872 F.2d at 911.

Through provisions such as 17 U.S.C. § 102(b), which excludes facts and ideas from copyright protection, the Copyright Act balances the desire to reward authors for their creations with the desire to protect and encourage intellectual development, which is possible only if one author can build on the work of others. *See, e.g.*, *Nash*, 899 F.2d at 1540. By holding authors liable for copyright infringement if the factual details of their work too closely resemble the factual details of a previous work, even if the facts are retold almost entirely in the authors' own words, the Tenth Circuit unduly and radically shifts this statutory balance in the copyright holder's favor.

As then-Chief Judge Kaufman of the Second Circuit succinctly put it: "[t]o avoid a chilling effect on authors who contemplate tackling a historical issue or event, broad latitude must be granted to subsequent authors who make use of historical subject matter." *Hoehling*, 618 F.2d at 978. This Court should grant *certiorari* in order to provide guidance in this vitally important area, and to ensure that Congress' carefully crafted balance is protected.

CONCLUSION

For the foregoing reasons, this Court should grant the petition for writ of *certiorari*.

Respectfully submitted,

KENNETH W. STARR
KANNON K. SHANMUGAM
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, DC 20005
(202) 879-5000

RICHARD G. WILKINS*
J. Reuben Clark Law School
513 J. Reuben Clark Building
Brigham Young University
Provo, UT 84602
(801) 422-2669

* *affiliation given for associational purposes only*

MARY ANNE Q. WOOD
Counsel of Record
KATHRYN O. BALMFORTH
WOOD CRAPO LLC
500 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
(801) 366-6060

KENT B LINEBAUGH
JONES, WALDO, HOLBROOK & MCDONOUGH
170 South Main Street
Salt Lake City, UT 84101
(801) 521-3200

September 23, 2002

APPENDIX

APPENDIX
TABLE OF CONTENTS

Page

Opinion of the Court of Appeals,
April 19, 2002 ..... 1a

Order of the Court of Appeals Denying Petition for Rehearing *En Banc*,
June 24, 2002 ..... 28a

Order of the District Court,
January 11, 2001 ..... 30a

APPENDIX A

IN THE UNITED STATES COURT OF APPEALS
FOR THE TENTH CIRCUIT

Nos. 01-4027 & 01-4036

GENE S. JACOBSEN,

Plaintiff-Appellant and Cross-Appellee,

versus

DESERET BOOK COMPANY, a Utah corporation;
DEAN HUGHES,

Defendants-Appellees and Cross-Appellants.

Appeal from the United States District Court
for the District of Utah

April 19, 2002

Before **KELLY**, Circuit Judge, **BRORBY**, Senior Circuit Judge, and **MURPHY**, Circuit Judge.

BRORBY, Senior Circuit Judge:

I. Introduction

Dr. Gene S. Jacobsen was a prisoner of war in the Philippines and Japan during World War II. After returning from military service, Dr. Jacobsen wrote his personal memoir entitled *Who Refused to Die.* In gripping detail, *Who Refused to Die* recounts Dr. Jacobsen's survival of the Bataan Death March and subsequent years of imprisonment and torture in various work camps.

In 1997, Deseret Book Company ("Deseret Book") published the first of a five-volume series written by Dr. Dean Hughes entitled *Children of the Promise.*[1] The series is a fictional work written primarily for members of the Church of Jesus Christ of Latter-day Saints. It portrays a Latter-day Saint family's life during World War II. The story of Wally Thomas, one of the family's sons, closely follows Dr. Jacobsen's experiences as related in *Who Refused to Die.*

In 1999, Dr. Jacobsen filed a complaint against Dr. Hughes and Deseret Book seeking an injunction and damages for copyright infringement under 17 U.S.C. §§ 106 and 501. After nearly a year of discovery, Deseret Book filed a motion asking the district court to dismiss the complaint for failure to state a claim pursuant to Federal Rule of Civil Procedure 12(b)(6) and award Deseret Book attorney fees. Dr. Hughes joined Deseret Book's Rule 12(b)(6) motion and filed a motion for summary judgment on several affirmative defenses. The district court granted the Rule 12(b)(6) motion, granted summary judgment on the affirmative defense of laches, and denied the request for attorney fees.

On appeal, Dr. Jacobsen challenges the district court's dismissal of his complaint pursuant to Fed.R.Civ.P. 12(b)(6) as well as the court's granting summary judgment on the affirmative defense of laches. Dr. Jacobsen also appeals the district court's refusal to strike defendants' expert reports or allow Dr. Jacobsen additional time to designate expert witnesses. Dr. Hughes and Deseret Book filed a cross-appeal seeking attorney fees. We exercise jurisdiction under 28 U.S.C. § 1291 and reverse the 12(b)(6) dismissal, the grant of summary judgment on laches, and the refusal to strike the expert reports. Both Dr. Jacobsen's request for additional time to

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[1] The individual volumes are titled, beginning with the first, *Rumors of War; Since You Went Away; Far From Home; When We Meet Again;* and *As Long as I Have You.*

designate experts and Dr. Hughes' and Deseret Book's request for attorney fees are moot.

II. Motion to Dismiss

Dr. Jacobsen argues the district court erred in granting Dr. Hughes' and Deseret Books' motion to dismiss.[2] "We review a dismissal under Rule 12(b)(6) de novo." *Wark v. United States*, 269 F.3d 1185, 1190 (10th Cir.2001). Our "'function on a Rule 12(b)(6) motion is not to weigh potential evidence that the parties might present at trial, but to assess whether the plaintiff's complaint alone is legally sufficient to state a claim for which relief may be granted.'" *Sutton v. Utah State Sch. for the Deaf & Blind*, 173 F.3d 1226, 1236 (10th Cir.1999) (quoting *Miller v. Glanz*, 948 F.2d 1562, 1565 (10th Cir.1991)).

In addition to the complaint, the district court may consider documents referred to in the complaint if the documents are central to the plaintiff's claim and the parties do not dispute the documents' authenticity. *See GFF Corp. v. Associated Wholesale Grocers, Inc.*, 130 F.3d 1381, 1384 (10th Cir.1997). Because Dr. Jacobsen's complaint referred to *Who Refused to Die* and the *Children of the Promise* series, and all the parties invited the

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[2] Normally a motion to dismiss for failure to state a claim upon which relief can be granted should be made prior to filing the answer or in the answer itself. Fed.R.Civ.P. 12(b)(6). If the defendant makes the motion after filing the answer, the motion should generally be treated as a motion for judgment on the pleadings. Fed.R.Civ.P. 12(c), (h)(2); *Lowe v. Town of Fairland, Okla.*, 143 F.3d 1378, 1381 n. 5 (10th Cir.1998); *Republic Steel Corp. v. Pennsylvania Eng'g Corp.*, 785 F.2d 174, 182 (7th Cir.1986). In keeping with the parties' designation, we refer to the motion as a 12(b)(6) motion to dismiss. We use the same standard when evaluating 12(b)(6) and 12(c) motions. *See Atlantic Richfield Co. v. Farm Credit Bank of Wichita*, 226 F.3d 1138, 1160 (10th Cir.2000) ("A motion for judgment on the pleading under Rule 12(c) is treated as a motion to dismiss under Rule 12(b)(6)."). Therefore, in this case, our decision would be the same whether considered as a 12(b)(6) motion or a 12(c) motion.

district court to consider these works, the district court properly considered the work in ruling on the 12(b)(6) motion.[3] *See Lewis v. Kroger Co.*, 109 F.Supp. 484, at 486 (S.D.W.Va.1952) (considering original and allegedly copied material in ruling on 12(b)(6) motion). When a district court considers the original work and the allegedly copyrighted work in deciding a 12(b)(6) motion, the legal effect of the works are determined by the works themselves rather than by allegations in the complaint. *See Droppleman v. Horsley*, 372 F.2d 249, 250 (10th Cir.1967) (holding the legal effect of an incorporated document considered on a motion to dismiss "'is to be determined by [the document's] terms rather than by the allegations of the pleader'" in the complaint) (quoting *Zeligson v. Hartman-Blair, Inc.*, 126 F.2d 595, 597 (10th Cir.1942)).

We cannot affirm the dismissal for failure to state a claim unless, after considering the complaint, *Who Refused to Die*, and the *Children of the Promise* series[4] in the light most favorable to Dr. Jacobsen, it appears beyond doubt Dr. Jacobsen can prove no set of facts in support of his claim that would entitle him to relief. *Stidham v. Peace Officer Standards & Training*, 265 F.3d 1144, 1149 (10th Cir.2001). To establish copyright infringement,

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[3] Although Dr. Jacobsen told the district court it could consider the *Children of the Promise* books, at oral argument on appeal Dr. Jacobsen argued we should consider only the complaint. We need not consider Dr. Jacobsen's new-found objection to reviewing the *Children of the Promise* series. *See John Zink Co. v. Zink*, 241 F.3d 1256, 1259 (10th Cir.2001) (quoting *United States v. Edward J.*, 224 F.3d 1216, 1222 (10th Cir.2000)) ("'The invited error doctrine prevents a party from inducing action by a court and later seeking reversal on the ground that the requested action was error.'").

[4] Despite the importance of the *Children of the Promise* series to this appeal, none of the parties designated the series as part of the record on appeal. We, therefore, have *sua sponte* supplemented the record with the five-volume *Children of the Promise* series. *See* 10th Cir. R. 10.3(B); *Cox v. United States*, 881 F.2d 893, 894 n. 1 (10th Cir.1989).

Dr. Jacobsen must prove "(1) ownership of a valid copyright and (2) 'copying of constituent elements of the work that are original.'" *TransWestern Publ'g Co., v. Multimedia Mktg. Assocs.*, 133 F.3d 773, 775 (10th Cir.1998) (quoting *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991)). The complaint clearly alleges Dr. Jacobsen has a federally registered copyright for *Who Refused to Die.* Thus, we need only determine whether the complaint and incorporated documents are sufficient to allege Dr. Hughes and Deseret Book copied *Who Refused to Die.*

Whether Dr. Hughes and Deseret Book copied *Who Refused to Die* "involves two distinct inquiries: first, whether [Dr. Hughes], as a factual matter, copied [Dr. Jacobsen's] work, and second, whether, as a mixed issue of fact and law, those elements that were copied were protected." *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1284 (10th Cir.1996). After reviewing the complaint and incorporated documents, we are satisfied Dr. Jacobsen could present evidence showing Dr. Hughes copied many of the experiences Dr. Jacobsen recorded in *Who Refused to Die.* The difficulty in this case arises in determining whether Dr. Hughes copied only unprotected facts or instead impermissibly copied Dr. Jacobsen's original expression.

It is well settled "no author may copyright facts or ideas." *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985). Thus, the copyright of a nonfiction work protects only "those aspects of the work—termed 'expression'—that display the stamp of the author's originality." *Id. See also Feist*, 499 U.S. at 348 ("[C]opyright protection may extend only to those components of a work that are original to the author."). "[A] copyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original —for example * * * facts, or materials in the public domain—as long as such use does not unfairly appropriate the author's original contributions." *Harper & Row*, 471 U.S. at 548 (quotation marks and citations omitted).

In order to prove copying of legally protectible material, a plaintiff must typically show substantial similarity between legally protectible elements of the original work and the allegedly infringing work. *Country Kids 'N City Slicks,* 77 F.3d at 1284. "This is primarily a qualitative rather than a purely quantitative analysis, and must be performed on a case-by-case basis." *Gates Rubber Co. v. Bando Chem. Indus., Ltd.,* 9 F.3d 823, 839 (10th Cir.1993) (citation and footnote omitted).[5] To decide whether two works are substantially similar we ask "'whether the accused work is so similar to the plaintiff's work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff's protectible expression by taking material of substance and value.'" *Country Kids 'N City Slicks,* 77 F.3d at 1288 (quoting *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.,* 672 F.2d 607, 614 (7th Cir.1982)). Determining whether there is

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[5] In determining whether a defendant has copied legally protectible material, we have sometimes found it useful to use an abstraction-filtration-comparison analysis. *See Country Kids 'N City Slicks,* 77 F.3d at 1284-85; *Gates Rubber,* 9 F.3d at 834. We have described this analysis as follows:

> At the abstraction step, we separate the ideas (and basic utilitarian functions), which are not protectable, from the particular expression of the work. Then, we filter out the nonprotectable components of the product from the original expression. Finally, we compare the remaining protected elements to the allegedly copied work to determine if the two works are substantially similar.

Country Kids 'N City Slicks, 77 F.3d at 1284-85. While abstraction-filtration-comparison analysis is useful in a variety of copyright cases, not every case requires extensive analysis. *Mitel, Inc. v. Iqtel, Inc.,* 124 F.3d 1366, 1372 (10th Cir.1997). Rather, "'the appropriate test to be applied and the order in which its various components are to be applied * * * may vary depending upon the claims involved, the procedural posture of the suit, and the nature of the [works] at issue.'" *Id.* (quoting *Gates Rubber,* 9 F.3d at 834 n. 12). Regardless of our method of distilling the protectible aspects of *Who Refused to Die,* the ultimate issue is whether the *Children of the Promise* series is substantially similar to protectible aspects of *Who Refused to Die. See Gates Rubber,* 9 F.3d at 839.

substantial similarity in cases involving fact-based works is particularly difficult.

> [T]he measure of how substantial a "substantial similarity" must be may vary according to circumstances. For many copyrights represent significant creative effort, and are therefore reasonably robust, whereas others reflect only scant creativity; the Supreme Court labels the latter "thin." It would seem to follow analytically that more similarity is required when less protectible matter is at issue. Thus, if substantial similarity is the normal measure required to demonstrate infringement, "supersubstantial" similarity must pertain when dealing with "thin" works.

4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.03[A], at 13-28 (2000) (hereinafter *Nimmer*). *See also TransWestern,* 133 F.3d at 776 (relying on Nimmer's "supersubstantial" similarity analysis). Because "[n]o easy rule of thumb can be stated as to the quantum of fragmented literal similarity permitted without crossing the line of substantial similarity," whether works are substantially similar is "a classic jury question." 4 *Nimmer, supra,* § 13.03[A][2], at 13-46 and n. 96 (2001). *Cf. King of the Mountain Sports, Inc. v. Chrysler Corp.,* 185 F.3d 1084, 1089 (10th Cir.1999) (holding the trier of fact should normally make the determination of similarity in a trademark infringement case, but the court can monitor the "outer limits" of similarity if "reasonable minds" could not differ on the question). In applying these principles to Dr. Jacobsen's appeal, we first distinguish the supersubstantial similarity analysis relied on by the district court. Then, we compare *Who Refused to Die* and the *Children of the Promise* series addressing precedent relied upon by Dr. Hughes and Deseret Book.

In ruling on the motion to dismiss, the district court found "[Dr.] Hughes copied some 'facts' from [Dr.] Jacobsen's memoir, but not significant original expression." Relying on *Feist Publications, Inc.*

v. Rural Telephone Service Co., 499 U.S. 340 (1991), and *TransWestern Publishing Co. v. Multimedia Marketing Associates*, 133 F.3d 773 (10th Cir.1998), two cases involving copied telephone directories, the district court applied a supersubstantial similarity test rather than the substantial similarity requirement traditionally applied in copyright infringement cases. The court noted several differences between *Who Refused to Die* and the character Wally in the *Children of the Promise Series*.

> Much of the *Children of the Promise* series deals with spiritual matters and a [sic] most of the volumes are devoted to Wally's large and extended family. [Dr.] Jacobson's [sic] memoir, on the other hand, does not emphasize spiritual matters except in passing. * * * Further, the memoir deals only with [Dr.] Jacobsen's experiences in a limited matter and does not expand much over time and geography as do [Dr.] Hughes' novels. It is clear to this court that Wally is not Gene Jacobsen.

Consequently, the district court concluded under "the * * * supersubstantial similarity test it is clear that [Dr.] Hughes did not copy any protectable aspects of the memoir."

We disagree. First, we conclude the district court gave undue weight to language in *Feist* and *TransWestern* incorrectly applying a "supersubstantial similarity test" in evaluating whether Dr. Hughes and Deseret Book copied protected elements of *Who Refused to Die*. In *Feist*, the Supreme Court held "the copyright in a factual compilation is thin." *Feist*, 499 U.S. at 349. In *TransWestern*, we stated "if substantial similarity is the normal measure required to demonstrate infringement, 'supersubstantial' similarity must pertain when dealing with thin works." *TransWestern*, 133 F.3d at 776 (quoting 4 *Nimmer, supra*, § 13.03[A], at 13.28 (1997)). The district court seized this language and applied what it called "the Tenth Circuit supersubstantial similarity test." We do not read *TransWestern* so broadly as to require us to apply a

supersubstantial similarity test to all fact-based works. Rather *TransWestern* merely reaffirmed "the measure of how substantial a 'substantial similarity' must be may vary according to circumstances." 4 *Nimmer, supra*, § 13.03[A], at 13-28 (2000). Because fact-based works differ "as to the relative proportion of fact and fancy," *Harper & Row*, 471 U.S. at 563, the quantum of similarity required to establish infringement differs in each case. Merely applying a supersubstantial similarity test to all fact-based works would ignore the differences between "sparsely embellished maps and directories" and "elegantly written biography." *Id.* In short, *Who Refused to Die* involves more creative effort and original expression than the telephone directories at issue in *Feist* and *TransWestern*. Therefore, Dr. Jacobsen could prove substantial similarity with less similarity than we would require if the allegedly infringed work were a telephone directory.[6]

Second, although the district court's catalogue of differences between *Who Refused to Die* and the *Children of the Promise* series is accurate, it is largely irrelevant. We realize the five-volume *Children of the Promise* series contains much material not taken from the single-volume *Who Refused to Die*. However, "a taking may not be excused merely because it is insubstantial with respect

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[6] Dr. Hughes and Deseret Book do not agree *Who Refused to Die* is entitled to greater protection than a telephone directory. They point to a sentence in *Harper & Row*: "The extent to which one must permit expressive language to be copied, in order to assure dissemination of the underlying facts, will thus vary from case to case." *Harper & Row*, 471 U.S. at 563 (quotation marks and citation omitted). Dr. Hughes and Deseret Book argue "[t]he point of this quotation, then, is that even highly creative expression might receive *less* protection when it is used to describe facts than it would in a fictional work." (Emphasis in original.) We agree *Who Refused to Die* should receive less protection than a purely fictional novel. However, we cannot see how this proposition leads to the conclusion *Who Refused to Die* should be treated as a telephone directory. We believe the quotation from *Harper & Row* merely reinforces the view substantial similarity should be decided on a case-by-case basis.

to the *infringing* work. As Judge Learned Hand cogently remarked, 'no plagiarist can excuse the wrong by showing how much of his work he did not pirate.'" *Harper & Row*, 471 U.S. at 565 (quoting *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936)). "The question in each case is whether the similarity relates to matter that constitutes a substantial portion of plaintiff's work—not whether such material constitutes a substantial portion of defendant's work." 4 *Nimmer, supra*, § 13.03[A][2], at 13-46 (2001). Thus we are not concerned with whether the copied material is a substantial part of the *Children of the Promise* series. Rather, we must consider whether Dr. Hughes and Deseret Book copied a substantial portion of *Who Refused to Die*.

With these clarifications in mind, we next compare *Who Refused to Die* and the *Children of the Promise* series. It is clear Dr. Hughes copied much of the plot line for Wally Thomas from *Who Refused to Die*. As we need not weigh the evidence, we make no attempt to compile an exhaustive list of protectible material a jury could find to have been copied. Suffice it to say the similarity goes beyond the bare facts that both works describe a World War II Army Air Corps Supply Sergeant who was captured by the Japanese, forced to march across the Bataan Peninsula, and imprisoned in various work camps. Both works tell how Japanese planes bombed an air field just as a soldier was delivering cigars.[7]

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[7] Dr. Jacobsen's memoir states:

> Not far from where I stood he stopped the truck and got out. He took from the seat of the truck a box of cigars that he had scrounged from somewhere. He opened the box and placed it on the truck's hood. Then, he dipped both hands into the box and came out with a double handful of cigars. Coming towards the trees, he began shouting, "Cigars? Cigars! Does anyone want a cigar?"
>
> Laughing at his antics, I turned around to see if he had any takers. No one was in sight.

Both describe a Japanese officer's anguish after he discovered an American prisoner of war serving on a work detail accidentally pulled up baby carrot plants.[8] Both recount the "humiliation" the

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> Instinctively I turned towards the small tower which had been constructed. Sure enough, the red flag was whipping excitedly in the breeze as if its very movement would be sufficient to alert us of approaching enemy planes.
>
> Almost simultaneously I heard the shrill, chilling whistle of the bombs from the Japanese planes overhead as they made their treacherous descent towards Clark Field.

Gene S. Jacobsen, *Who Refused to Die* 20 (Jan. 1, 1995) (unpublished manuscript). Dr. Hughes wrote:

> He braked and then bounced out of the truck. He had a box in his hand, which he slapped onto the hood of the truck. Then he reached in and pulled out a double handful of cigars. "Cigars! Cigars!" he yelled above the drone of the engines.
>
> Wally wondered where Sandy had managed to scrounge a box of cigars, and he looked around to see who wanted one—but saw no one at all. Instantly, Wally guessed what was happening. He spun to look at the lookout tower the men had built. A red flag was waving in the breeze—the sign for an air attack. At the same moment, Wally heard the whistle of dropping bombs.

Dean Hughes, 1 *Children of the Promise: Rumors of War* 436 (1997).

[8] *Who Refused to Die* reads:

> The Jap, seeing what had happened, dropped to his knees and picked up a handful of the weeds and carrots. Though he couldn't speak a word of English, it was easy, from the expression on his face and from his voice, to tell what he was thinking and saying as he separated the carrots from the weeds. I know he must have been quietly sobbing, "My poor little carrots, my poor little carrots."

Jacobsen, *supra,* at 133. *Children of the Promise* reads:

> I thought for a minute the Jap was going to cry. He bent down and showed Frank which ones were carrots and which were weeds. He hardly knew a word of English, but he kept showing ol' Frank and jabbering away. It was almost like he was saying, "Oh, son, look what you've done to my lovely little carrots."

protagonist felt when guards assigned him to the "honey detail" and required him to empty their outhouses.[9] In some instances, the copying goes beyond close paraphrasing and reproduces Dr. Jacobsen's words exactly. Consider the following example. The first paragraph is Dr. Jacobsen's description of his journey to unite with American troops after the war ended. The second is Dr. Hughes' description of the same event in the fictional life of Wally Thomas.

> Approaching the sailors the second time, one of the fellows drove his souvenir sword into the deck of the ship and said somewhat fiercely, "*Listen you guys! General MacArthur* said that we had the authority *to use any means* of transportation *necessary* to get out of Japan, and this boat is necessary for us to reach American troops. *We* are *going to* get across *this bay with you or without you. If you want to take us across and get paid for your troubles, fine. If you don't, get off the ship, and we'll take* ourselves across!"

Jacobsen, *supra,* at 193-94 (emphasis added).

Dean Hughes, 2 *Children of the Promise: Since You Went Away* 188 (1997).

[9] *Who Refused to Die* at 130.

> The assignment to be avoided if at all possible, was the "honey" detail that daily cleaned the Japanese toilets and carried the contents to the farm where it was spread around the plants. The work was bearable, but the humiliation was almost too great.

Children of the Promise, Vol. 2 at 186.

> Each morning Wally would receive a work assignment. * * * [W]orst of all was the "honey" detail. The work was not terribly strenuous, but the humiliation was almost more than he could stand. A work crew would carry the contents of the outhouses to the fields, an then they would spread the human waste around the plants in the garden.

> This time it was Potts who walked on ahead. He was carrying a souvenir sword of his own. When he stepped onto the deck, he shouted, "We need to talk," and he slammed his sword into the deck, sticking it up by its point. * * * "*Listen* to me *you guys,*" Potts went on. "*General* Douglas *MacArthur* has authorized us *to use any means* we find *necessary* to reach American troops. *We*'re *going to* cross *this bay with you or without you. If you want to take us across and get paid for your troubles, fine. If you don't, get off the ship, and we'll take* her across ourselves."

Dean Hughes, 4 *Children of the Promise: When We Meet Again* 427-28 (1999) (emphasis added).

Dr. Hughes and Deseret Book do not believe these and other passages reveal copying. They argue "[Dr.] Hughes never copied [*Who Refused to Die*] verbatim. He retold the factual events in his own words and style, and he placed them in a fictional context of his own creation." We disagree. Dr. Hughes and Deseret Book never directly address why the preceding example and others do not amount to verbatim copying. Instead, they cite several cases suggesting some verbatim copying is permissible. *See Narell v. Freeman,* 872 F.2d 907, 911 (9th Cir.1989); *Suid v. Newsweek Magazine,* 503 F.Supp. 146, 148 (D.D.C.1980); *Alexander v. Haley,* 460 F.Supp. 40, 46 (S.D.N.Y.1978); *Norman v. Columbia Broad. Sys., Inc.,* 333 F.Supp. 788, 797 (S.D.N.Y.1971). We conclude these cases are inapplicable to the case before us.

Narell, Alexander, and *Norman* are distinguishable because those cases involved verbatim copying of only a few words and phrases. *See Narell,* 872 F.2d at 911; *Alexander,* 460 F.Supp. at 46; *Norman,* 333 F.Supp. at 797. For example, in *Narell* the court held there was no copyright infringement when the verbatim copying amounted to a few descriptive phrases like "cow path" and

"hordes of gold seekers." *Narell*, 872 F.2d at 911. Indeed, the above cited example from the *Children of the Promise* series reveals Dr. Hughes and Deseret Book arguably copied more than a few words and phrases.

Suid is also inapplicable. In *Suid*, the court held "[t]he author of a factual work may not * * * claim copyright in statements made by others and reported in the work since the author may not claim originality as to those statements." *Suid*, 503 F.Supp. at 148. We acknowledge the words contained in both paragraphs of the above-cited example were enclosed in quotation marks. We agree quotations may be freely copied if the quotation is recorded contemporaneously or taken directly from a written source as in *Suid*. Dr. Jacobsen did not, however, contemporaneously record the quotations or copy them from a written source. For this reason, a trier of fact might conclude the material in quotation marks in *Who Refused to Die* was original expression rather than the actual words used. Dr. Jacobsen may have enclosed the material in quotations merely to allow him to speak in the voice of a third party while recording his story. Because the issue of whether the dialogue in Who Refused to Die is original expression or fact turns, at least in part, on additional evidence to be presented at trial, the question should be determined by the trier of fact rather than the court.

The Supreme Court's decision in *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), is particularly instructive on the issue of verbatim copying. In *Harper & Row*, the Supreme Court upheld a district court's finding of copyright infringement. *Id.* at 541-42. Harper & Row owned the copyright to President Ford's unpublished memoir. *Id.* at 542. Prior to publication of the memoir, a magazine obtained a copy of the memoir and published an article including verbatim quotes from the memoir. *Id.* at 542-43. The Supreme Court held even though President Ford's memoir was a factual work, the magazine's verbatim copying of the memoir appropriated original expression and amounted to copyright infringement. *Id.* at 548-49. Likewise,

when viewed in the light most favorable to Dr. Jacobsen, the *Children of the Promise* series contains passages arguably copied verbatim from *Who Refused to Die*. Because *Harper & Row* establishes verbatim copying from a memoir appropriates the author's original expression, we could only uphold the district court's dismissal if the copying were so minor as to be beyond the outer limits of substantial similarity. We conclude the copying is not so minor as to remove the substantial similarity decision from the domain of the trier of fact.

Because we hold the *Children of the Promise* series contains enough material for a trier of fact to find verbatim copying, we need not address whether close paraphrasing of an historical work is sufficient to establish a copyright violation.[10] *See id.* at 548. We acknowledge the Supreme Court has not settled this issue. However, the Second Circuit has held close paraphrasing of unpublished letter in an historical biography violated copyright law. *Salinger v. Random House, Inc.*, 811 F.2d 90, 93, 96-97 (2d Cir.1987). Nothing in our opinion would preclude the Tenth Circuit from adopting the Second Circuit's approach in the future.

In conclusion, when viewing the complaint, the *Children of the Promise* series, and *Who Refused to Die* in the light most favorable to Dr. Jacobsen, we conclude Dr. Jacobsen could prove a set of facts entitling him to relief. Portions of the *Children of the Promise* series could be seen as verbatim copying of Dr. Jacobsen's original expression. These instances are numerous enough to allow a jury to determine whether the works are

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[10] For this reason we do not undertake extensive analysis of two cases cited by Dr. Hughes and Deseret Book. In their brief, Dr. Hughes and Deseret Book direct us to *Walker v. Time Life Films, Inc.*, 615 F.Supp. 430 (S.D.N.Y.1985) and *Polsby v. St. Martin's Press, Inc.*, No. 97 Civ. 690(MBM), 1999 WL 225536 (S.D.N.Y. Apr.19, 1999) (unpublished decision). Neither of these cases involved verbatim copying. *Walker*, 615 F.Supp. at 436-37; *Polsby*, 1999 WL 225536, at *4. Similarly, we need not analyze portions of *Narell* discussing paraphrasing to reach our decision in this case.

substantially similar. We, therefore, reverse the district court's ruling on the 12(b)(6) motion.

III. Laches

Next, we address whether the district court correctly granted summary judgment after determining Dr. Jacobsen's claims were barred by laches. Because there are disputes as to material facts, we hold the district court erred in granting summary judgment on the laches issue.

As an initial matter, we must determine the appropriate standard for reviewing the district court's decision. Dr. Jacobsen argues we should apply a *de novo* standard. In contrast, Dr. Hughes advocates an abuse of discretion standard. We have used the abuse of discretion standard to review a district court's application of the laches defense after a bench trial. *Mile High Indus. v. Cohen,* 222 F.3d 845, 852, 857 (10th Cir.2000); *Jicarilla Apache Tribe v. Andrus,* 687 F.2d 1324, 1328, 1337 (10th Cir.1982). However, when a district court applies the laches doctrine to dismiss a claim on summary judgment, we review the district court's decision de novo. *Hutchinson v. Pfeil,* 105 F.3d 562, 564 (10th Cir.), *cert. denied,* 522 U.S. 914 (1997). In keeping with Tenth Circuit precedent, we apply de novo review in this case.[11]

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[11] Some circuits use a bifurcated standard to review a district court's grant of summary judgment on a laches defense. For example, the Seventh Circuit held "while our review of the record is *de novo* in determining whether there are any disputed issues of material fact, our review of whether the district court properly applied the doctrine of laches is under an abuse of discretion standard." *Hot Wax, Inc. v. Turtle Wax, Inc.*, 191 F.3d 813, 819 (7th Cir.1999). *See also Wanlass v. General Elec. Co.*, 148 F.3d 1334, 1337 (Fed.Cir.1998); *National Ass'n of Gov't Employees v. City Pub. Serv. Bd.*, 40 F.3d 698, 707-08 (5th Cir.1994). Although we do not adopt this approach, we note our decision would be the same under this standard. Our de novo review of the record convinces us there are genuine issues of material fact. Consequently, we would not need to undertake the abuse of discretion

"Summary judgment is appropriate if there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law." *Hutchinson,* 105 F.3d at 564. "In determining whether the defendant is entitled to summary judgment, we view all facts and reasonable inferences therefrom in the light most favorable to the plaintiff." *Id.* (citing *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 255 (1986)).

"In order to prove the affirmative defense of laches, the defendant must demonstrate that there has been an unreasonable delay in asserting the claim and that the defendant was materially prejudiced by that delay." *Hutchinson,* 105 F.3d at 564. "Generally speaking, the relevant delay is the period from when the plaintiff knew (or should have known) of the allegedly infringing conduct, until the initiation of the lawsuit in which the defendant seeks to counterpoise the laches defense." *Danjaq LLC v. Sony Corp.,* 263 F.3d 942, 952 (9th Cir.2001).

In granting Dr. Hughes' summary judgment motion, the district court noted "the facts in this matter are highly disputed; however the facts regarding laches * * * are to be determined by the court." The district court then found "[Dr.] Jacobsen had knowledge of the material used by [Dr.] Hughes as early as 1994 and no later than 1996." In addition, the court found Dr. Jacobsen "had ample opportunity to let [Dr.] Hughes know of his disapproval as early 1996" but instead delayed in bringing his claim until 1999 causing "extreme prejudice to [Dr.] Hughes." Consequently, the district court concluded Dr. Jacobsen's claims were barred by laches.

We disagree with the district court's conclusion summary judgment was appropriate on the issue of laches. Although a district court can make factual findings related to laches after a bench trial, *Mile High Indus.,* 222 F.3d at 857, the court should not make factual findings when addressing a summary judgment

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analysis.

motion based on laches, *Hutchinson,* 105 F.3d at 564. Rather than deferring to district court's finding of fact, we view the record in the light most favorable to Dr. Jacobsen. *Id.* When viewing the record in this light, we find disputes of material facts. If Dr. Jacobsen's version of the facts are accepted, Dr. Hughes is not entitled to summary judgment on the laches defense.

Both parties agree Dr. Jacobsen and Dr. Hughes first met in 1994. As the district court found, "what happened at the meeting and thereafter is heavily disputed by the parties." In his deposition, Dr. Jacobsen testified Dr. Hughes was interested in gathering background information on the war in the Pacific for use in writing a series of fictional books. Because he thought it would be useful as background information, Dr. Jacobsen gave Dr. Hughes a copy of *Who Refused to Die.* If this is accepted as true, we cannot see how this meeting could have alerted Dr. Jacobsen to the possibility Dr. Hughes would use *Who Refused to Die* in such a way as to raise copyright concerns.

Dr. Jacobsen's next contact with Dr. Hughes occurred in March 1996. The parties agree Dr. Hughes mailed Dr. Jacobsen a copy of a portion of the manuscript for the first book in *The Children of the Promise* series. The exact content of the material Dr. Hughes sent is disputed. Dr. Hughes contends the material should have put Dr. Jacobsen on notice of the nature of his use of *Who Refused to Die.* Dr. Jacobsen argues he did not receive all of the material Dr. Hughes claims to have sent. Dr. Jacobsen testified the materials did not include excerpts containing stories from *Who Refused to Die.* Although Dr. Jacobsen admitted he only "skimmed" the material, he testified he read the material carefully enough to identify any familiar stories. Again, if Dr. Jacobsen's version of the facts are accepted, we cannot conclude Dr. Jacobsen knew or should have known about potential copyright claims in 1996.

Dr. Hughes argues "even if we fully credit [Dr.] Jacobsen's testimony that he did not know exactly *how* [*Who Refused to Die*] was being used, he indisputably *should* have known, if that issue was of any concern to him at all." (Emphasis in original.) He suggests Dr. Jacobsen should have asked questions to ensure Dr. Hughes would not violate Dr. Jacobsen's copyright. While Dr. Jacobsen was expected to "exercise reasonable diligence in protecting his rights," *Jicarilla Apache Tribe,* 687 F.2d at 1338, laches should not be applied if Dr. Jacobsen was "justifiably ignorant of the facts creating his * * * cause of action," *Lawson v. Haynes,* 170 F.2d 741, 744 (10th Cir. 1948). We cannot conclude Dr. Jacobsen had a responsibility to inquire into Dr. Hughes' use of *Who Refused to Die* absent any reason to suspect Dr. Hughes was using *Who Refused to Die* in an inappropriate way. *See West v. American Tel. & Tel. Co.,* 311 U.S. 223, 240-41 (1940) (upholding a district court's rejection of laches defense even though the plaintiff did not conduct an inquiry to reveal unlawful conduct because there was no evidence suggesting the plaintiff had reason for suspicion).[12]

Next, Dr. Hughes argues Dr. Jacobsen should have discovered the nature of Dr. Hughes' use of *Who Refused to Die* when the first volume of the *Children of the Promise* series was published in March 1997. Because the district court relied on its factual determination that Dr. Jacobsen should have known about Dr.

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[12] Dr. Hughes argues Dr. Jacobsen should have been alerted to his use of *Who Refused to Die* because "the cover letter accompanying the excerpts [sent to Dr. Jacobsen in 1996] gave strong cues as to exactly how [Dr.] Hughes was using [*Who Refused to Die*]." We cannot conclude the letter, when viewed in the light most favorable to Dr. Jacobsen, raised the suspicion Dr. Hughes was inappropriately copying *Who Refused to Die*. The letter itself advised Dr. Jacobson, "[r]emember that Wally is not you." The letter also stated, "I am writing fiction and not telling *your* story." Thus, the letter could reasonably be viewed as confirming Dr. Jacobsen's belief Dr. Hughes was using *Who Refused to Die* only for background information.

Hughes' use of *Who Refused to Die* by 1996, the court did not consider whether laches would apply if the publication of the first volume was Dr. Jacobsen's first opportunity to discover his claims. We consider this argument because we can affirm for any reason supported by the record but not relied on by the district court. *Hayes v. Whitman,* 264 F.3d 1017, 1025 (10th Cir.2001).

Nevertheless, we conclude Dr. Hughes' argument is without merit.

Even if we assume the publication of the first volume of the *Children of the Promise* series should have immediately alerted Dr. Jacobsen to his potential copyright claims, we cannot conclude Dr. Jacobsen's claims are barred by laches. Dr. Jacobsen filed suit against Dr. Hughes and Deseret Book within three years of the publication of the first volume of the *Children of the Promise* series. Rather than deciding copyright cases on the issue of laches, courts should generally defer to the three-year statute of limitations, 17 U.S.C. § 507(b), provided by the Copyright Act.

> Because laches is a judicially created equitable doctrine, whereas statutes of limitations are legislative enactments, it has been observed that in deference to the doctrine of the separation of powers, the Supreme Court has been circumspect in adopting principles of equity in the context of enforcing federal statutes. Accordingly, when a limitation on the period for bringing suit has been set by statute, laches will generally not be invoked to shorten the statutory period.

United States v. Rodriguez-Aguirre, 264 F.3d 1195, 1207-08 (10th Cir.2001) (quotation marks, citations, and alterations omitted). *See also Lyons P'ship, L.P. v. Morris Costumes, Inc.,* 243 F.3d 789, 797 (4th Cir.2001) (holding "separation of powers principles dictate that an equitable timeliness rule adopted by courts cannot bar claims that are brought within the legislatively prescribed statute of limitations" in the Copyright Act). Although "it is possi-

ble, in rare cases, that a statute of limitations can be cut short by the doctrine of laches," *Rodriguez-Aguirre,* 264 F.3d at 1208, we see no reason to supplant the statute of limitations in this case.

In arguing laches should be applied in this case, Dr. Hughes directs us to *Jackson v. Axton,* 25 F.3d 884, 888 (9th Cir.1994), *overruled on other grounds by Fogerty v. Fantasy, Inc.,* 510 U.S. 517, 531-32, 534 (1994). Although *Jackson* held a court can apply laches in a copyright case, the facts in *Jackson* are different from the facts before us. In *Jackson,* the plaintiff knew of his claim by 1975 but did not file suit until 1991. 25 F.3d at 886, 889. Given the prolonged delay, the Ninth Circuit held laches was applicable. *Id.* at 889. *See also Danjaq,* 263 F.3d at 950, 954 (upholding a district court's application of laches to prevent a plaintiff from pursuing copyright infringement claims when plaintiff filed suit "at least twenty-one years—and more likely, thirty-six years" after having knowledge of the potential claims). In contrast, Dr. Jacobsen filed suit less than three years after publication of the first volume. It does not seem unreasonable to allow Dr. Jacobsen three years from the time he should have known of his claim to evaluate the viability of instituting a lawsuit or pursue out-of-court remedies. *Cf. New Era Publ'ns Int'l v. Henry Holt & Co.,* 873 F.2d 576 (2d Cir.1989) (holding laches did not bar copyright holders' claims for damages when plaintiff learned of alleged infringement two years prior to bringing suit). Consequently, we defer to the Copyright Act's statute of limitations in this case.

When viewing the record in the light most favorable to Dr. Jacobsen, we conclude his delay in filing suit was reasonable. Consequently we need not address whether Dr. Hughes was materially prejudiced by the delay. We reverse the district court's ruling on the summary judgment motion and remand for further proceedings.

IV. Discovery Issues

Next, Dr. Jacobsen argues "[t]he district court erred in denying Dr. Jacobsen's motion for additional time to file rebuttal expert reports or in the alternative to strike defendant's expert reports and designations." We conclude the district court abused its discretion in refusing to strike the expert reports.

On August 1, 2000, Dr. Hughes and Deseret Book filed the reports of four expert witnesses, Marilyn A. Lashner, Merrill R. Norman, Paul Rawlins, and Allan Wittman, pursuant to Federal Rule of Civil Procedure 26(a)(2). Dr. Hughes and Deseret Book offered the expert reports to establish the bulk of the profits from the *Children of the Promise* series are attributable to their work rather than Dr. Jacobsen's work.

Rule 26(a)(2) requires expert reports "contain a complete statement of all opinions to be expressed." Fed.R.Civ.P. 26(a)(2)(B). A party is under a continuing duty to supplement the expert report if there are additions or changes to what has been previously disclosed. Fed.R.Civ.P. 26(a)(2)(C), 26(e)(1). "A party that without substantial justification fails to disclose information required by Rule 26(a) * * * is not, unless such failure is harmless, permitted to use as evidence at a trial * * * any * * * information not so disclosed." Fed.R.Civ.P. 37(c)(1). Arguing the expert reports were not complete, Dr. Jacobsen filed a motion asking the district court to postpone his deadline for filing rebuttal reports until after the defendant's expert reports were complete, or, in the alternative, strike the defendant's expert reports.

After a hearing on this issue, the district court denied Dr. Jacobsen's motion. It first noted Dr. Jacobsen was given the opportunity to submit his own expert reports to substantiate his claim of copyright infringement. Dr. Jacobsen did not submit expert reports because he believes he can establish copying through Dr. Hughes own admissions. The district court then reasoned Dr. Jacobsen "was fully aware that the burden regarding damages is the

defendants' burden," and "should not [have been] surprised that defendants did choose to rely on expert testimony in order to prove that profits were derived from material other than the allegedly copyrighted material." Consequently, the court concluded "[Dr. Jacobsen] had the same opportunity to provide expert witnesses as [Dr. Hughes and Deseret Book] and should not now be given an opportunity to file late reports or strike defendants' timely reports." Although the district court stated it had "considered the law * * * relevant to [Dr. Jacobsen's] motion," it did not mention Rule 26(a) or Rule 37(c).

In responding to Dr. Jacobsen's appeal, Dr. Hughes and Deseret Book do not argue their expert reports were complete. Instead, they claim the expert reports could not be complete because Dr. Jacobsen never "identified the alleged infringement with specificity." Because Dr. Jacobsen never provided a paragraph-by-paragraph analysis to show which portions of the *Children of the Promise* series were copied, Dr. Hughes and Deseret Book contend the expert reports were necessarily incomplete. Their experts "could only tell what method they would use" to calculate the profits attributable to Dr. Hughes and Deseret Book when they later "issue their final opinions." In addition, Dr. Hughes and Deseret Book argue the district court was within its discretion in refusing to grant Dr. Jacobsen additional time to file rebuttal expert reports. They believe allowing Dr. Jacobsen more time to file rebuttal expert reports would have "meant abandoning the trial date," which was set for January 8, 2001. Finally, Dr. Hughes and Deseret Book assert the incomplete reports did not preclude Dr. Jacobsen from filing rebuttal reports because Dr. Jacobsen could have submitted rebuttal expert reports with "the same level of generality" as the incomplete reports.

Because the district court did not find the expert reports complied with Rule 26(a), and Dr. Hughes and Deseret Book acknowledge the reports were preliminary and incomplete, we turn directly to the issue of whether Rule 37(c) nevertheless allows the

district court to allow the experts to testify on the basis of the incomplete reports. *See In re TMI Litigation Cases,* 922 F.Supp. 997, 1005 n. 9 (M.D.Pa.1996) (holding preliminary expert reports do not satisfy Rule 26(a)); *Smith v. State Farm Fire & Cas. Co.,* 164 F.R.D. 49, 53 (S.D.W.Va.1995) (same). Rule 37(c) permits a district court to refuse to strike expert reports and allow expert testimony even when the expert report violates Rule 26(a) if the violation is justified or harmless. Fed.R.Civ.P. 37(c). "The determination of whether a Rule 26(a) violation is justified or harmless is entrusted to the broad discretion of the district court." *Woodworker's Supply, Inc. v. Principal Mut. Life Ins. Co.,* 170 F.3d 985, 993 (10th Cir.1999). Nevertheless, we can hold the district court abused its discretion if the decision is based "on an erroneous conclusion of law," *Kiowa Indian Tribe v. Hoover,* 150 F.3d 1163, 1165 (10th Cir.1998), or would result in "fundamental unfairness in the trial of the case," *Orjias v. Stevenson,* 31 F.3d 995, 1005 (10th Cir.), *cert. denied,* 513 U.S. 1000 (1994).

Although a district court can allow evidence violating Rule 26(a) only if the violation was justified or harmless, *Jones v. Lincoln Elec. Co.,* 188 F.3d 709, 728 (7th Cir.1999), "[a] district court need not make explicit findings concerning the existence of a substantial justification or the harmlessness" of a Rule 26(a) violation, *Woodworker's Supply,* 170 F.3d at 993. Nevertheless, the court should consider the following factors: "(1) the prejudice or surprise to the party against whom the testimony is offered; (2) the ability of the party to cure the prejudice; (3) the extent to which introducing such testimony would disrupt the trial; and (4) the moving party's bad faith or willfulness." *Id.* We conclude the district court abused its discretion by misapplying two of these factors and not addressing the other two factors.

Initially, we note the district court did not address whether the Rule 26(a) violation was justified or harmless. With respect to the first factor, the district court opined Dr. Jacobsen should not have been surprised because experts are often used by defendants in

copyright cases. This ignores the purpose of Rule 26(a) expert reports. The reports are intended not only to identify the expert witness, but also "to set forth the substance of the direct examination." Fed.R.Civ.P. 26(a)(2) advisory committee note (1993). Such disclosure is necessary to allow the opposing party "a reasonable opportunity to prepare for effective cross examination and perhaps arrange for expert testimony from other witnesses." *Id.* Thus, to avoid prejudice Dr. Jacobsen needed to know the substance of the experts' testimony. After reviewing the expert reports, it appears likely the experts' testimony at trial will contain substantially more information than was presented in the expert reports. Dr. Lashner's report reveals she had reviewed *Who Refused to Die,* the first volume of the *Children of the Promise* series, and the jacket covers for volumes, two, three, and four of the series. At the time of her expert report she was "in the process of reviewing the remaining materials." Mr. Norman's report "summarize[d] the revenues, expenses and net profits associated with the *Children of the Promise* series through June 30, 2000." Mr. Rawlins' report warns his "percentages are for explanatory purposes only," and his report "is subject to amendment after additional analysis." Similarly, Mr. Whitman's report states he "expect[s] to do additional research on these issues between now and the trial and will refine these calculation." At trial, it is likely Dr. Hughes and Deseret Book will want Dr. Lashner to testify about her review of the complete series, Mr. Norman to testify about more recent revenue and expenses, and Mr. Rawlins and Mr. Whitman to testify about their refined calculations. We, therefore, cannot agree Dr. Jacobsen would not be prejudiced by the introduction of testimony not contained in the expert reports.

The second factor we consider is whether Dr. Jacobsen could somehow cure the potential prejudice. The district court suggests Dr. Jacobsen could have prevented potential prejudice if he had filed expert reports to support his copyright infringement claim. This finding suffers the same infirmity as the district court's analysis

on prejudice. Prejudice results because the expert reports did not reveal what the experts will testify to at trial. Therefore, nothing Dr. Jacobsen could have done prior to filing of the expert reports would have cured the prejudice. Dr. Hughes and Deseret Book argue Dr. Jacobsen could have filed rebuttal expert reports that were similarly general in nature. Again, this remedy would not eliminate prejudice because Dr. Jacobsen still would not know what testimony the defendants' experts would give at trial.

The district court's order does not reveal its analysis concerning the third factor. Even if the district court had made specific findings as to whether the undisclosed expert testimony would have disrupted the trial, the situation now facing the parties is somewhat different. As Dr. Hughes and Deseret Book argue, when the district court issued the order the scheduled trial date was just over a month away. Consequently, the court may have decided it would be less disruptive to allow testimony based on the incomplete reports than to allow Dr. Hughes and Deseret Book time to file complete reports. Since we are remanding this case for further proceedings, trial is no longer imminent and the district court could allow more time for discovery without disrupting a scheduled trial. *See Standard v. Union Pacific R.R. Co.*, 198 F.3d 258, 1999 WL 992973, at *3 (10th Cir. Nov. 2, 1999) (unpublished opinion) (reversing a district court's discovery ruling because, after a remand, trial was not imminent).

With respect to the fourth factor, the district court did not make a finding as to whether Dr. Hughes and Deseret Book acted in bad faith. Desert Book and Dr. Hughes argue they acted in good faith. They contend their expert reports would have been more complete if Dr. Jacobsen had been more forthcoming in responding to discovery requests. Generally, a court should "'not excuse non-compliance with Rule 26 by one party for the reason that the other party may not have fully complied'" with discovery requests. *Carney v. KMart Corp.*, 176 F.R.D. 227, 230 (S.D.W.Va.1997) (quoting *Smith*, 164 F.R.D. at 54). *See also Rambus, Inc. v.*

Infineon Techs. AG, 145 F.Supp.2d 721, 734 (E.D.Va.2001). If Dr. Hughes and Deseret Book thought Dr. Jacobsen had unfairly avoided discovery their recourse was a motion to compel. Fed.R.Civ.P. 37.

Assuming, however, Dr. Hughes and Deseret Book acted in good faith, their good faith alone would not be enough to overcome the other factors. If the experts are allowed to testify on the basis of their incomplete reports, Dr. Jacobsen will be prejudiced. Absent more complete disclosure by the experts, Dr. Jacobsen's prejudice cannot be cured. As the case is no longer on the eve of trial, the district court could allow Dr. Hughes and Deseret Book time to file complete expert reports without jeopardizing the trial schedule. If Dr. Hughes and Deseret Book are allowed to file complete reports, Dr. Jacobsen would have thirty days from the time the reports were filed to file rebuttal reports. Fed.R.Civ.P. 26(a)(2)(C). For these reasons, we reverse the district court's denial of Dr. Jacobsen's motion to strike the expert reports. In accordance with this decision, we need not address Dr. Jacobsen's alternative request for additional time to file rebuttal expert reports.

V. Attorney's Fees

Dr. Hughes and Deseret Book argue the district court should have awarded them attorney's fees because they were the prevailing party in an action under the Copyright Act. In light of our holding, this argument is moot.

VI. Conclusion

For the foregoing reasons we **REVERSE** the district court dismissal for failure to state a claim. We **REVERSE** the district court's grant of summary judgment on the laches defense. We also **REVERSE** the district court's refusal to strike four incomplete expert reports. The appeal relating to attorney's fees is moot, and we **REMAND** for further proceedings consistent with this opinion.

APPENDIX B

IN THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

Nos. 01-4027 & No. 01-4036

GENE S. JACOBSEN,

Plaintiff-Appellant and Cross-Appellee,

versus

DESERET BOOK COMPANY, a Utah corporation; **DEAN HUGHES,**

Defendants-Appellees and Cross-Appellants.

Appeal from the United States District Court for the District of Utah

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ORDER
Filed June 24, 2002

Before **KELLY**, Circuit Judge, **BRORBY**, Senior Circuit Judge, and **MURPHY**, Circuit Judge.

Deseret Book Company and Dean Hughes' petition for rehearing is denied.

The suggestion for rehearing en banc was transmitted to all of the judges of the court who are in regular active service as required by Fed. R. App. P. 35. As no member of the panel and no judge in regular active service on the court requested that the court be polled, the suggestion is also denied.

Entered for the Court

PATRICK FISHER, Clerk of Court

by: /s/
Deputy Clerk

APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF UTAH
CENTRAL DIVISION

GENE S. JACOBSEN,
Plaintiff,

versus

DESERET BOOK COMPANY, a Utah corporation;
DEAN HUGHES,

Defendants.

Case No. 2:99-CV-893K

ORDER

This matter is before the court on defendant Deseret Book's Motion to Dismiss which has been joined in by defendant Dean Hughes; and defendant Hughes' separate Motion for Summary Judgment. Also before the court is defendants' Motion for Attorney's Fees and defendant Hughes' Motion to Strike factual assertions in Jacobsen's Memorandum in Opposition to the Motion for Summary Judgment. The matter came on for hearing on Monday December 4, 2000. The plaintiff was represented by Brent O. Hatch. Defendant Deseret Book was represented by Mary Ann Q. Wood. Defendant Hughes was represented by Kent B. Linebaugh. Oral argument was heard and the matter was taken under advisement. The court has considered all pleadings, memoranda, and other materials submitted by the parties. The

court has further considered the law and facts relevant to the parties' motions. Now being fully advised, the court enters the following order.

I. Factual Background

The plaintiff in this matter, Gene S. Jacobsen, alleges that defendant Hughes unlawfully copied Jacobsen's memoir, *Who Refused to Die,* in the writing of Hughes' successful five volume *Children of the Promise* series which is published by defendant Deseret Book. Jacobsen wrote his memoir *Who Refused to Die* shortly following his release as a war prisoner in 1945. The memoir is a personal account of Jacobsen's experiences in the Bataan Death March and as a prisoner of war in the Phillippines and in Japan. In 1978 Jacobsen made five typewritten copies for his family members. In 1981 Jacobsen revised the memoir and distributed about 100 copies, free of charge, throughout Singapore. In 1994 he again revised the manuscript making an additional 75 copies for family and friends. In the 1978 and 1981 versions Jacobsen included a copyright symbol on the manuscript. He did not include one initially on the 1994 version but added one later. The copyright was not registered until after this suit was commenced in 1999.

Defendant Dean Hughes entered into an agreement with Deseret Book in early 1994 to author his *Children of the Promise* series. At about this time he became acquainted with Jacobsen's memoir through his wife who worked with Jacobsen's son. Hughes requested a meeting with Jacobsen in order to discuss his work and experiences. The two met at length at least once, however, what happened at the meeting and thereafter is heavily disputed by the parties. Hughes states that he at least had implied permission to use Jacobsen's material. Hughes states that he sent an early version of Volume I to Jacobsen with a note stating that "I don't want to do anything you wouldn't feel good about, so let me know if anything is either wrong or somehow troubles you". Jacobsen responded to

this letter on March 21, 1999 with a note that stated in part that he had read the material and "looked forward to the finished product". Jacobsen now states that he never read the material and that the excerpts that he did glance at did not include any material from his memoir.

Hughes formally dedicated Volume II to Jacobsen and further encouraged Jacobsen to publish his memoir. Hughes states that he was not aware of Jacobsen's objections until sometime after Volume III had been published. Jacobsen argues that Hughes was aware of his objections much earlier. Jacobsen's attempts to publish his memoir were rejected and the memoir has never been published. Jacobsen alleges that the character of Wally in *Children of the Promise* is based upon him and that Hughes copied his original expression from *Who Refused to Die*. This action was filed in November of 1999, two months after Volume IV of Hughes' series was published.

II. Discussion

A. Motion to Dismiss: Defendants argue that this matter should be dismissed on the pleadings on the basis that Mr. Jacobsen's factual story can not be copyrighted. Copyright laws protect only "originality," which is both a statutory and a constitutional requirement for copyright protection. Thus, facts are not protected because "no one may claim originality as to facts." 1 M. Nimmer & D. Nimmer, *Copyright* § 2.11[A], p. 2-157 (1990).

Defendants rely heavily on *Feist Publications, Inc., v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991) and *Trans Western Pub. Co., v. Multimedia Marketing Assoc., Inc.*, 133 F.3d 773 (10th Cir.1998). In *Feist* the Court stated that: "If a compilation author clothes facts with an original collocation of words, he or she may be able to claim a copyright in this written expression. Others may copy the underlying facts from the publication but not the precise words used to present them". The

Court explained the difference between facts and copyrightable compilations as follows: "A compilation of facts or preexisting data is only protectable insofar as it features original selection, arrangement or coordination of facts as they appear in the work as a whole. *Feist* further states that "infringement must be shown by a substantial similarity of protectable expression, not just an overall similarity between the works". The Tenth Circuit takes this standard even further in *Trans Western*.

> The mere fact that a work is copyrighted does not mean that every element of the work may be protected. * * * Determining whether an infringement of a compilation copyright has occurred is particularly difficult where less than the entire work is copied * * * especially when a competitor can take "the bulk of the factual material from a preexisting compilation without infringement." The protection available for a compilation is "thin."

The Tenth Circuit goes on to set an even stricter standard for "thin" materials:

> Although a compilation gains copyright protection with only minimal creativity in the selection and arrangement of facts, Feist's statement that the copyright is "thin" has implications when the holder sues an alleged infringer. "It would seem to follow analytically that more similarity is required when less protectable matter is at issue. Thus, if substantial similarity is the normal measure required to demonstrate infringement, 'supersubstantial' similarity must pertain when dealing with "thin" works.

(citations omitted). Defendants argue that this is the standard that must be applied.

Jacobsen's Complaint alleges that Hughes copied "events, sequences of events, and characters." Defendants argue that events and sequences of events in Jacobsen's work are facts which cannot

be copyrighted. Defendants state that the assertion that Hughes copied characters is just another way of asserting that he copied facts. There are no original characters in Jacobsen's work and Hughes states that Wally is an original character not based upon Mr. Jacobsen at all. As far as copying distinctive words, the defendants argue that it is not clear what is meant by this. Hughes does not copy precise words of Jacobsen. He clearly sets part of his story in the factual setting of Jacobsen's memoir and occasionally uses individual phrases found in the manuscript, but they are not original nor distinctive. Words and phrases that are not original and are part of the factual context can not be copyrighted.

Defendants argue that the supersubstantial standard as set forth by the Tenth Circuit must apply in this matter and that the factual memoir of the plaintiff's is not protected material. The defendants further cite to *Narell v. Freeman,* 872 F.2d 907 (9th Cir.1989). In that matter the plaintiff had published a factual work about the history of Jews in San Francisco. The defendant published a fictional work about a Jewish family living in San Francisco and admitted consulting plaintiff's book during her research and taking language from it. The court dismissed the case holding that:

> * * * Although one may conclude that [defendant] appropriated [plaintiff's] historical research, the appropriation of expressive elements is minimal. The more numerous paraphrasing cited by [plaintiff] cannot be said to take the expressive elements of her work; instead unprotected factual details are taken, although in some cases commonly-used expressions are echoed. * * * [Defendant's] borrowings did not take a "sequence of creative expression," as opposed to an ordinary phrase, and therefore were not infringing.

Narell, which predates the Tenth Circuit's supersubstantial similarity test, is directly on point. *Narell* applies an extrinsic and intrinsic test. The extrinsic test determines whether the two works

are substantially similar in general ideas and compares the individual features of the works to find specific similarities between the plot, theme, dialogue, mood, setting, pace, characters and sequence of events. The intrinsic test is used to determine whether the forms of expression of the two works are substantially similar; it is subjective, depending on the response of an ordinary, reasonable reader. The *Narell* court discussed that when viewed as a whole, the works have slight resemblance to one another.

Plaintiff argues that Hughes' books are no more than a fictionalized account of Gene Jacobsen's memoir and that the substantially similar requirement has been met. Plaintiff first argues that *Feist* and *Trans Western* are distinguishable because they both deal with telephone directories which is not the same as the case at hand. Although this is certainly true, the language of these cases can be applied to the facts of this case. Plaintiff then argues that facts can be protected expression. The major case relied upon by the plaintiff is *Salinger v. Random House*, 811 F.2d 90 (2nd Cir.1987). In that case J.D. Salinger brought a copyright infringement action against the publisher of an unauthorized biography of Salinger and its author Ian Hamilton. Hamilton had copied published, copyrighted letters authored by Salinger. For example, Salinger expressed his unfavorable opinion of presidential candidate Wendell Willkie in a letter stating that: "He looks to me like a guy who makes his wife keep a scrapbook for him." Hamilton reported this by stating that Salinger "had fingered Willkie as the sort of fellow who makes his wife keep an album of his press cuttings." The court found that Hamilton copied original expression of Salinger and therefore infringed the copyrighted letters. The *Narell* court distinguishes *Salinger* as dealing with "highly original expressions".

The court has read the books at issue in this case,[1] including Mr. Jacobsen's memoir and all volumes of Mr. Hughes' *Children of the Promise* series. Having read the works at issue it is clear to this court that Mr. Hughes copied some "facts" from Mr. Jacobsen's memoir, but not significant original expression. The character of Wally is a complex character that is placed in various settings. Only a portion of his story takes place in the Phillippines and Japan. Further, Wally has a father who deems him a quitter and Wally has strayed somewhat from the Mormon religion. Much of the Children of the Promise series deals with spiritual matters and a most of the volumes are devoted to Wally's large and extended family. Jacobson's memoir, on the other hand, does not emphasize spiritual matters except in passing. There is little indication that Mr. Jacobsen is seen as a quitter by his father or anyone else. Further, the memoir deals only with Jacobsen's experiences in a limited matter and does not expand much over time and geography as do Hughes' novels. It is clear to this court that Wally is not Gene Jacobsen.

This case is analogous to *Narell v. Freeman,* 872 F.2d 907 (9th Cir.1989) in that Hughes appropriated historical research yet did not copy significant "original expression" from Jacobsen's memoir. This matter is distinguishable from *Salinger v. Random House*, 811 F.2d 90 (2nd Cir.1987) in that in *Salinger,* the defendant not only copied Salinger's telling of factual events, but copied much of Salinger's original and highly expressive commentary on the factual events. The fact that Salinger had an unfavorable opinion of Wendell Willkie for example, may have been a fact that could not be copyrighted; however, Mr. Salinger's comment that Willkie "looks to me like a guy who makes his wife keep a scrapbook for him" is a highly original expression and not

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[1] *Who Refused to Die* is part of the record before the court. *The Children of the Promise* series is referenced in the Complaint and therefore part of the record.

factual at all. In the case at hand Mr. Hughes has created fictional characters and placed one of them in a factual setting which is borrowed in part from Mr. Jacobsen's memoir. However, under the Tenth Circuit supersubstantial similarity test it is clear that Hughes did not copy any protectable aspects of the memoir. In reading the memoir it appears to this court that although it is a thoughtful work of courage, honor, discipline and perseverance, it is a historical work that is not protectable under the copyright laws.

B. Motion for Summary Judgment: Defendant Hughes has brought a Motion for Summary Judgment arguing laches, equitable estoppel and waiver. Waiver is a defense for the finder of fact and the facts in this matter are highly disputed; however the facts regarding laches and equitable estoppel are to be determined by the court. *See Mile High Industries v. Cohen,* 222 F.3d 845 (10th Cir.2000).

As stated, the court finds that Hughes did not utilize any protectable material from Jacobsen's memoir, however, even assuming that the memoir does contain protectable material, Jacobsen is barred under the doctrine of laches from pursuing a claim. The Tenth Circuit has held that the defense of laches consists of two elements: (1) inexcusable delay by plaintiff in instituting suit; and (2) such delay results in prejudice to the defendant. *See Brunswick Corp. v. Spinit Reel Co.,* 832 F.2d 513, 523 (10th Cir.1987). The record before this court demonstrates that Jacobsen had knowledge of the material used by Hughes as early as 1994 and no later than 1996. Hughes sent excerpts from Volume I to Jacobsen in March of 1996 with the letter stating "I don't want to do anything you wouldn't feel good about, so let me know if anything is either wrong or somehow troubles you." Hughes interviewed Jacobsen more than once with the first interview being in 1994 and Jacobsen responded to Hughes' 1996 letter with a letter that stated he had read the material and looked forward to the finished product. Jacobsen did not express any disapproval of *The Children of the Promise* series until 1999,

after Volume III had been published. Had Jacobsen voiced his disapproval in 1996 Hughes would have had the opportunity to take the offending material out of the books. For Jacobsen to wait until three volumes of the series had been published before voicing his disapproval, when it is clear he had ample opportunity to let Hughes know of his disapproval as early as 1996 results in extreme prejudice to Hughes. Hughes could have produced his series without relying upon Jacobsen's manuscript and then would not have been placed in the position he now finds himself. Jacobsen's delay in informing Hughes about his disapproval bars Jacobsen's recovery under the doctrine of laches.

The evidence before this court at this time does not support granting summary judgment on the affirmative defense of estoppel. The distinction between the affirmative defenses of laches and estoppel is that laches turns on whether plaintiff has unjustifiably delayed enforcing his rights. Estoppel turns on whether plaintiff has induced the offending conduct. Although it appears that it is possible that the March 12, 1996 letter stating that Jacobsen was looking forward to the finished product, may have influenced Mr. Hughes decision to continue with the now offensive plot line, based upon the evidence before the court at this time it does not seem clear that Jacobsen's conduct induced Hughes to rely upon *Who Refused to Die.* Rather, it was Jacobsen's failure to inform Hughes that he disapproved of the use of his work that lead to the situation at hand. Therefore, defendant's Motion for Summary Judgment on the grounds of estoppel is denied.

Lastly, defendant's Motion to Strike Jacobsen's factual assertions in his Opposition to the Motion for Summary Judgment is denied. The court is capable of reading the factual assertions and determining what material is relevant and admissible and what is not. It is unnecessary to strike Jacobsen's factual assertions.

For the reasons stated herein, it is hereby

ORDERED that Defendants' Motion to Dismiss is **GRANTED**. Defendant Hughes' Motion for Summary Judgment is **GRANTED** as to the affirmative defense of laches and **DENIED** as to the affirmative defenses of waiver and equitable estoppel. Defendant Hughes' Motion to Strike is **DENIED** and Defendants' Motion for attorney's fees is also **DENIED**. Each party is to bear its own costs.

DATED this 11th day of January, 2001.

/s/

DALE A. KIMBALL
United States District Judge

Supreme Court, U.S.
FILED
OCT 25 2002
CLERK

No. 02-482

IN THE

Supreme Court of the United States

DESERET BOOK COMPANY and DEAN HUGHES,

Petitioners,

v.

GENE S. JACOBSEN,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

BRIEF IN OPPOSITION

BRENT O. HATCH
Counsel of Record
MARK H. RICHARDS
HATCH, JAMES & DODGE
Attorneys for Respondent
10 West Broadway
Suite 400
Salt Lake City, Utah 84101
(801) 363-6363

176986

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

TABLE OF CONTENTS

	Page
Table of Cited Authorities	ii
Statement of the Case	1
A. Factual Background	1
B. The Lower Courts' Proceedings	4
Reason for Denying the Petition	9
The Court Of Appeals Correctly Held On A Motion To Dismiss That Where Numerous Portions Of An Alleged Infringing Work Could Be Seen As Verbatim Copying Of The Author's Original Expression In A Copyrighted Historical Work, A Jury Should Be Allowed To Determine Whether The Works Are Substantially Similar.	9
A. The Tenth Circuit's Decision Below Is Not in Tension With Prior Decisions of This Court.	9
B. The Tenth Circuit's Decision Is Consistent With Decisions Of The Ninth Circuit And Other Circuits.	18
C. The Question Presented Is Not A Recurring One of Exceptional Importance.	26
Conclusion	27

TABLE OF CITED AUTHORITIES

Page

Cases:

Apple Computer, Inc. v. Microsoft Corp., 779 F. Supp. 133 (N.D. Cal. 1991) 20, 21

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991) ..... *passim*

Harper & Row, Publishing Inc. v. Nation Enterprises, 471 U.S. 539 (1985) ..... *passim*

Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir. 1980) 21, 22, 23, 24, 25

Narell v. Freeman, 872 F.2d 907 (9th Cir. 1989) 19, 21, 23, 24, 25

Nash v. CBS, Inc., 899 F2d 1537 (7th Cir. 1990) .. 24, 25

Rosemont Enterprises, Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966) 21, 22, 23

Salinger v. Random House, Inc., 811 F.2d 90 (2d Cir. 1990) 19, 20, 23, 24, 25

Wainwright Securities Inc. v. Wall Street Transcript Corp., 558 F.2d 91 (2d Cir. 1997) 13

Cited Authorities

Page

Rules:

Fed. R. Civ. P. 12(b)(6) 4

Secondary Sources:

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STATEMENT OF THE CASE

In an effort to create an issue worthy of review by this Court, Petitioners have overstated the record in crafting their "Question Presented." Whereas Petitioners claim the Tenth Circuit allowed a claim for copyright infringement to proceed against them despite a finding of only "minimal" copying, the record in this case clearly establishes that Petitioners' appropriation of Respondent's original expression was "substantial." Indeed, the Tenth Circuit cited several lengthy examples in its decision of verbatim copying by Petitioners.

A. Factual Background

Dr. Gene S. Jacobsen is a decorated World War II hero who survived a three and one half year ordeal in the Philippines as a prisoner of war to the Japanese. Dr. Jacobsen is a survivor of the infamous Bataan Death March. Following the war, in late 1945 and early 1946, Dr. Jacobsen recorded in long hand his personal account, among other things, of the traumatic experiences and emotions he endured and the feelings he experienced as a prisoner of war. Aplt. App. 258-59. In 1984, Dr. Jacobsen, with the help of his wife, converted his long hand recording into a 200-plus page manuscript that he entitled *Who Refused to Die*. Aplt. App. 12. Dr. Jacobsen has a federally registered copyright in his manuscript and is the owner of all rights, title, and interests in and to *Who Refused to Die*. Aplt. App. 12.

In the fall of 1994, Petitioner Dean Hughes ("Hughes") began working on a series of fictional books set in World War II. Hughes planned that a significant portion of his series would focus on the war in the Philippines. Prior to writing his first book in the planned series, Hughes received a copy

of *Who Refused to Die* from Dr. Jacobsen's son. Aplt. App. 261. Hughes read the manuscript and then contacted Dr. Jacobsen and requested that they meet to discuss the war in the Philippines. Aplt. App. 261, 314.

In December 1994, Hughes met with Dr. Jacobsen and Dr. Jacobsen's wife, Barbara, in the Jacobsen's home and discussed information about the war. Aplt. App. 261. During this meeting, Hughes informed the Jacobsen's that Petitioner Deseret Book Company ("Deseret Book") would be publishing his series. Dr. Jacobsen told Hughes that he intended to submit *Who Refused to Die* to Deseret Book for review and hoped that Deseret Book would publish *Who Refused to Die*. Aplt. App. 262. At no time during this meeting or at any other time did Hughes request or receive permission to use, copy, paraphrase, or fictionalize the material in *Who Refused to Die*, or to use Dr. Jacobsen and his experiences as the basis for a central character in Hughes' planned series. Aplt. App. 314-315.

In the fall of 1995, Dr. Jacobsen's daughter submitted a copy of *Who Refused to Die* to Deseret Book. Aplt. App. 263. Deseret Book rejected the manuscript claiming that it was not commercially viable. Aplt. App. 264. During the same time period that Deseret Book was reviewing *Who Refused to Die*, Hughes had submitted for publication through Deseret Book Volume I of his planned series, now titled *Children of the Promise*. Although Hughes, thereafter, sent a portion of the material he had written to Dr. Jacobsen, Aplt. App. 264, he did not send any material that alerted Dr. Jacobsen to Hughes' intention to copy, paraphrase, and/or fictionalize Dr. Jacobsen's copyrighted manuscript. Aplt. App. 316-17. In a short note to Hughes, Dr. Jacobsen stated that the small amount of material he had received from

Hughes made difficult to "piece together" the storyline or comprehend the overall objective of Hughes' project. Aplt. App. 316-17; App. 149. Dr. Jacobsen has testified that he is "100 percent positive" that the material Hughes sent to him did not include material later added to *Children of the Promise* taken from *Who Refused to Die*. Aplt. App. 316-17.

Petitioners assert in their Petition for Writ of Certiorari that Hughes' copying from Dr. Jacobsen's memoir was "minimal." In fact, the evidence developed in discovery demonstrates that a significant portion of the *Children of the Promise* series was taken directly from Dr. Jacobsen's copyrighted manuscript. At his deposition, Hughes testified that "many of the pages, ***sometimes whole chapters***" from the *Children of the Promise* series were taken directly from *Who Refused to Die*. Aplt. App. 319-20 (emphasis added). Hughes testified that when he was writing the *Children of the Promise* series, he would keep Dr. Jacobsen's manuscript open and in front of him so that he could draft his books directly out of Dr. Jacobsen's manuscript. Aplt. App. 320. Hughes further testified that he used "much" from Dr. Jacobsen's manuscript and that the material came "directly out of" Dr. Jacobsen's manuscript and that he "pretty well [told] the story as it existed in [Dr. Jacobsen's] journal" because he thought that using Dr. Jacobsen's story as is would be more "compelling as a part of my plot." Aplt. App. 320.

Dr. Jacobsen did not learn that Hughes was using his life story as recorded in *Who Refused to Die* in Hughes' series until after both Volumes I and II of the series had been published. Despite the fact that Hughes and Deseret Book were timely notified that Dr. Jacobsen had contacted attorneys to pursue legal action against them for copyright infringement, Hughes and Deseret Book nevertheless

subsequently completed and published additional volumes of the series. Aplt. App. 272. Dr. Jacobsen filed his Complaint against Deseret Book and Hughes in November 1999. Aplt. App. 19.

B. The Lower Courts' Proceedings

Nearly a year after Dr. Jacobsen filed his complaint and after discovery in this case was substantially complete, Petitioners filed a Motion to Dismiss with the district court on October 10, 2000, Petitioners argued that although Dr. Jacobsen alleged, and the evidence showed, that Petitioners substantially copied and fictionalized his memoir, Dr. Jacobsen had not specifically alleged that Petitioners infringed on any protectible expression. On December 4, 2000, the matter was heard before the district court. On January 11, 2001, the district court issued an Order granting Petitioner Deseret Book's Motion to Dismiss. Applying the "supersubstantial similarity" test outlined by the Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), the district court held that Dr. Jacobsen's memoir was "a historical work that is not protectable under the copyright laws," and dismissed the lawsuit.

On appeal, the Tenth Circuit reversed the district court's Rule 12(b)(6) dismissal of Dr. Jacobsen's claims. The Tenth Circuit began its decision by emphasizing the fact that it was reviewing a Motion to Dismiss and stating:

> We cannot affirm the dismissal for failure to state a claim unless, after considering the complaint, *Who Refused to Die*, and the *Children of the Promise* series in the light most favorable to

> Dr. Jacobsen, it appears beyond doubt Dr. Jacobsen can prove no set of facts in support of his claim that would entitle him to relief.

Jacobsen v. Deseret Book Company, 287 F.3d 936, 942 (10th Cir. 2002). Because it ultimately concluded that numerous portions of the *Children of the Promise* series could be seen as verbatim copying of Dr. Jacobsen's original expression in *Who Refused to Die*, the Tenth Circuit reversed the district court's dismissal of Dr. Jacobsen's claims and held that a jury should be allowed to determine whether the works are substantially similar.

In reaching its conclusion, the Tenth Circuit began by stating that "the difficulty in this case arises in determining whether Dr. Hughes copied only unprotected facts or instead impermissibly copied Dr. Jacobsen's original expression," as it is undisputed that Hughes copied many of Dr. Jacobsen's experiences in *Who Refused to Die*. *Id.* Relying on the Court's decisions in *Harper & Row, Publishing Inc. v. Nation Enterprises*, 471 U.S. 539 (1985) and *Feist*, the Tenth Circuit stated the well-settled principle that "no author may copyright facts or ideas" and a copyright therefore protects "only those aspects of the work—termed expression—that display the stamp of the author's originality." *Id.*, citing *Harper & Row*, 471 U.S. at 547; *Feist*, 499 U.S. at 348. In order to prove copying of legally protectible material, the Tenth Circuit found that Dr. Jacobsen must show "substantial similarity" between the "legally protectible elements of the original work and the allegedly infringing work." *Id.* at 942-43. In turn, the Tenth Circuit held that in order to determine "substantial similarity" it must ask:

> Whether the accused work is so similar to the plaintiff's work that an ordinary reasonable person

> would conclude that the defendant unlawfully appropriated the plaintiff's protectible expression by taking material of substance and value.

Id. at 943. With this framework established, the Tenth Circuit turned to the district court's dismissal, which it rejected on two grounds.

First, the Tenth Circuit held that the district court incorrectly applied the "supersubstantial similarity" test outlined by the Court in *Feist* to Dr. Jacobsen's memoir. The Tenth Circuit found that a court is not required to apply the supersubstantial similarity test to all fact-based works. Because fact-based works differ "as to the relative proportion of fact and fancy," it held that the "quantum of similarity required to establish infringement differs in each case." *Id.* at 944, quoting *Harper & Row*, 471 U.S. at 563. The Tenth Circuit also found that merely applying a supersubstantial similarity test to all fact-based works would ignore the differences between "sparsely embellished maps and directories" and "elegantly written biography." *Id.*, quoting *Harper & Row*, 471 U.S. at 563. Accordingly, the Tenth Circuit concluded that because *Who Refused to Die* involves more creative effort and original expression than the telephone directories at issue in *Feist*, Dr. Jacobsen could prove substantial similarity with less similarity than required with a telephone directory. *Id.*

Second, the Tenth Circuit found that the district court incorrectly focused on the ***differences*** between *Who Refused to Die* and Petitioners' *Children of the Promise* series rather than the two works' similarities. The Tenth Circuit held that "a taking may not be excused merely because it is insubstantial with respect to the infringing work." *Id.* at 945,

quoting *Harper & Row*, 471 U.S. at 565. Instead, "the question in each case is whether the similarity relates to matter that constitutes a substantial portion of plaintiff's work—not whether such material constitutes a substantial portion of defendant's work." *Id.*, quoting 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.03[A][2], at 13-46 (2001). Thus, the Tenth Circuit concluded that it must consider whether Petitioners copied a substantial portion of *Who Refused to Die*.

After rejecting the district court's analysis, the Tenth Circuit engaged in its own thorough comparison of *Who Refused to Die* with the *Children of the Promise* series. It found that Hughes obviously copied extensively from Dr. Jacobsen's original expression in *Who Refused to Die*. The Tenth Circuit stated:

> As we need not weigh the evidence, ***we make no attempt to compile an exhaustive list of protectible material*** a jury could find to have been copied. Suffice it to say ***the similarity goes beyond the bare facts*** that both works describe a World War II Army Air Corps Supply Sergeant who was captured by the Japanese, forced to march across the Bataan Peninsula, and imprisoned in various work camps.

Id. at 945 (emphasis added).

While the Tenth Circuit, which was considering the district court's grant of a motion to dismiss for failure to plead a cause of action and was not therefore required to make a complete list of every instance of copying, it did, by way of example, provide ***four*** lengthy excerpts from both works that clearly demonstrate Petitioner Hughes' copying

went well beyond the bare facts and appropriated Dr. Jacobsen's original expression.[1] Indeed, the Tenth Circuit found that in many instances Hughes copied ***verbatim*** whole passages, as opposed to a few words or phrases, from Dr. Jacobsen's memoir. *Id.* at 947-48.

The Tenth Circuit noted that certain words contained in one of the examples it provided were enclosed in quotation marks. It agreed that quotations may be freely copied "if the quotation is recorded contemporaneously or taken directly from a written source." *Id.* at 947. The Tenth Circuit held, however, that Dr. Jacobsen's words were neither. *Id.* It concluded therefore that the trier of fact could conclude that the material in quotation marks in *Who Refused to Die* was original expression rather than the actual words used. *Id.* As the Tenth Circuit noted, "Dr. Jacobsen may have enclosed the material in quotations merely to allow him to speak in the voice of a third party while recording his story." *Id.*

In conclusion, the Tenth Circuit examined the *Harper & Row* opinion for its instruction on the issue of verbatim copying. It found that even though the memoir at issue in *Harper & Row* was a factual work, this Court held that the defendant's verbatim copying of the memoir appropriated original expression and amounted to copyright infringement. *Id.*, citing Harper & Row, 471 U.S. at 548-49. Relying on *Harper & Row*, the Tenth Circuit concluded that the *Children of the Promise* series contains enough material for a trier of

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1. The specifics of three of these examples are found in footnotes 7-9 of the Tenth Circuit's opinion. The fourth example is found in the body of the court's opinion. Several more similar examples are found in Respondent's briefs to the Tenth Circuit.

act to find verbatim copying[2] of Dr. Jacobsen's original expression and that Dr. Jacobsen could, therefore, prove a set of facts entitling him to relief. *Id.* at 948.

Thereafter, Petitioners requested an *en banc* hearing from the Tenth Circuit. That request was unanimously denied. Petitioners now request that the Court accept certiorari in a case that has not progressed beyond a motion to dismiss. This Court should decline.

REASON FOR DENYING THE PETITION

THE COURT OF APPEALS CORRECTLY HELD ON A MOTION TO DISMISS THAT WHERE NUMEROUS PORTIONS OF AN ALLEGED INFRINGING WORK COULD BE SEEN AS VERBATIM COPYING OF THE AUTHOR'S ORIGINAL EXPRESSION IN A COPYRIGHTED HISTORICAL WORK, A JURY SHOULD BE ALLOWED TO DETERMINE WHETHER THE WORKS ARE SUBSTANTIALLY SIMILAR.

A. The Tenth Circuit's Decision Below Is Not in Tension With Prior Decisions of This Court.

Petitioners argue that the Tenth Circuit's decision is inconsistent with the general framework for copyright infringement of factual works set forth by the Court in *Harper & Row* and *Feist*. Petitioners' argument is misguided.

2. While the Tenth Circuit held that the *Children of the Promise* series contains enough material for the trier of fact to find verbatim copying, it specifically stated that nothing in its opinion would preclude the Tenth Circuit from adopting an approach in the future which recognizes that close paraphrasing of an historical work is sufficient to establish a copyright violation. *Id.* at p. 948.

An examination of the Court's holdings in *Harper & Row* and *Feist* clearly demonstrates that the Tenth Circuit's decision in this matter is entirely consistent with this Court's precedent.

Harper & Row involved a copyright infringement claim brought against the political magazine, The Nation, for publishing an article lifting excerpts from a novel written by President Ford containing his unpublished memoirs. Harper & Row owned the copyright to President Ford's memoir, which the Court characterized as "a historical narrative or autobiography." *See Harper & Row*, 471 U.S. at 563. The Nation obtained a copy of the memoir prior to its publication and published an article including verbatim quotes from the memoir.

While the Court began with the proposition that the law generally recognizes a greater need to disseminate works based on fact rather than those based on fiction, the Court recognized that substantial differences exist between different types of factual works:

> Even within the field of fact works, there are gradations as to the relative proportion of fact and fancy. One may move from sparsely embellished maps and directories to elegantly written biography. The extent to which one must permit expressive language to be copied, in order to assure dissemination of the underlying facts, will thus vary from case to case.

Id. at 563.

After examining the two works at issue in *Harper & Row*, the Court concluded that while some of the short quotes appropriated from President Ford's memoir[3] were "arguably necessary adequately to convey the facts," the "subjective descriptions" that lie in the "author's individualized expression" that were copied "exceed[ed] that necessary to disseminate the facts." *Id.* at 563-64. Thus, the Court found that The Nation had appropriated far more expression than was necessary to disseminate the underlying facts of President Ford's expressive work.

Petitioners rely heavily on the dissent in *Harper & Row*, and apparently regard Justice Brennan's analysis of the "threshold question of copyrightability" as the controlling law of the Court. Petitioner's reliance on *Harper & Row*'s dissent is misplaced. While it is true, as Petitioners point out, that the majority did not take issue with Justice Brennan's analysis of the question of copyrightability, it is important to note that the majority refused to even reach the question of copyrightability in its opinion. Indeed, Justice Brennan chided the majority for failing to conduct such an analysis. *Id.* at 580 ("The Court finds no need to resolve the threshold copyrightability issue. . . Because I disagree with the Court's fair use holding, it is necessary for me to decide the threshold copyrightability question"). The majority did not agree or disagree with Justice Brennan's analysis for the simple fact that it found such analysis unnecessary. The majority's silence cannot be taken as an approval of the dissent's analysis on the question of copyrightability as Petitioners apparently urge.

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3. For example, the Court cited President Ford's characterization of the White House tapes as the "smoking gun" as perhaps "so integral to the ideal expressed as to be inseparable from it." *Id.*

Moreover, regardless of whether Justice Brennan's dissent were viewed as controlling on the issue of copyrightability, nothing in the Tenth Circuit's decision in this case conflicts with Justice Brennan's analysis. Petitioners' summary of the dissent in *Harper & Row* is incomplete and misleading.

Justice Brennan began his opinion by noting the basic tenant that copyright protection extends to an author's literary form but precludes any claim of copyright to facts. Accordingly, he found that a claim for copyright infringement must be "based on the taking of literary form, as opposed to the ideas or information contained in a copyrighted work." *Id.* at 582. Justice Brennan stated, the test for determining whether an author's literary form has been appropriated proceeds along two axes:

> ***How closely*** has the second author tracked the first author's particular language and structure of presentation; and ***how much*** of the first author's language and structure has the second author appropriated.

Id. at 583 (emphasis in original). Justice Brennan also specified that the protection of literary form must "proscribe more than merely word-for-word appropriation of substantial portions of an author's work." *Id.* at 583 n.5. Otherwise, as Justice Brennan noted, "a plagiarist could avoid infringement by immaterial variations." *Id.*

With this framework established, Justice Brennan then compared the works at issue. Justice Brennan first examined the language used by The Nation in its article and concluded that the information "was ***not in the form of paraphrase at***

all, but took the form of ***synopsis*** of lengthy discussions in the Ford manuscript." *Id.* at 584 (emphasis added). While Justice Brennan did find that The Nation occasionally used ***sentences*** that closely resembled the language used by President Ford in his memoir, he specifically noted that:

> The Nation ***paraphrased nothing approximating the totality of a single paragraph***, much less a chapter or the work as a whole. At most The Nation paraphrased ***disparate isolated sentences*** from the original. A finding of infringement based on paraphrase generally requires far more close and substantial a tracking of the original language than occurred in this case.

Id. at 585-86, citing *Wainwright Securities Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91 (2d Cir. 1977) (emphasis added).

Justice Brennan next examined the structure of presentation of The Nation's article and found that it did not mimic the structure of President Ford's memoir. *Id.* at 586. He, instead, determined that the information presented in The Nation's article ***did not appear in the same sequence*** as President Ford's memoir and, in fact, was drawn from ***scattered sections*** of President Ford's work. *Id.*

Based on his examination of the two works, Justice Brennan concluded that when the Nation's article was not directly quoting President Ford, the language and structure of the article did not so closely and substantially track President Ford's language as to constitute an appropriation of his literary form. *Id.* at 587.

Nothing in the Tenth Circuits opinion is inconsistent with the holding of the majority in *Harper & Row* or Justice Brennan's dissent. Petitioners argue that the Tenth Circuit's decision conflicts with *Harper & Row* because the Tenth Circuit, purportedly, "made no threshold effort to identify which components of Jacobsen's memoir constituted unprotected fact, and which constituted protected expression." Pet. Brief at p. 12. A careful reading of the opinions in *Harper & Row* demonstrates that nothing in the decision requires a court to "abstract" the unprotected facts from the protected expression of a copyrighted work as Petitioners argue. Indeed, in making his comparison of the works at issue in *Harper & Row*, Justice Brennan broadly examined the language used by The Nation to determine the extent of its verbatim copying or paraphrasing of sentences, paragraphs or chapters and then examined the overall structure of The Nation's article to determine if it tracked the same sequence as President Ford's memoir.

The Court's decision in *Harper & Row* establishes that while facts or ideas are not copyrightable, an author's "individualized expression" or the "literary form" used to describe and convey ideas or facts is protected under the copyright laws. The dissenting opinion in *Harper & Row* is in accord. Accordingly, the law proscribes verbatim copying or using "immaterial variations" of the author's original expression or literary form.

The Tenth Circuit's decision is consistent with controlling precedent. The Tenth Circuit found evidence demonstrating that Hughes copied verbatim significant portions of Dr. Jacobsen's individualized expression of his life experiences in *Who Refused to Die*. Moreover, it specifically rejected the claim that Hughes merely copied a

few words or phrases. To the contrary, it found that Hughes copied entire passages and portions of Dr. Jacobsen's memoir. The Tenth Circuit's decision is not in conflict with *Harper & Row*.

Petitioners also claim that the Tenth Circuit's decision is contrary to the Court's decision in *Feist*. Petitioners argue that *Feist* establishes that in the context of all factual works, only verbatim (i.e. use of the "precise words") copying of the author's original expression gives rise to a claim of copyright infringement. Thus, according to Petitioners, copyright protection for all factual works is "thin." Petitioners essentially argue that there is no difference in the amount of original expression in a historical work such as Dr. Jacobsen's memoir than what exists in the telephone directory at issue in *Feist*.

Feist involved a copyright infringement action by a telephone utility against a telephone directory that used listings from the utility's white pages in its publication. The Court began its opinion by noting that facts, because they are neither "discovered" nor "created", do not constitute an act of authorship, and are therefore ineligible for copyright protection. *Feist*, 499 U.S. at 347. On the other hand, factual compilations "may possess the requisite originality . . . [because] [t]he compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers." *Id.* at 348. Therefore, the Court concluded that choices as to selection and arrangement of data, so long as they are sufficiently creative, may be protected by the copyright laws. *Id.*

The Court noted, however, that the copyright in a compilation is not all-inclusive as protection extends only to the author's original expression or contribution. The *Feist* decision emphasized that "the copyright in a factual compilation is thin." *Id.* at 349. Accordingly, a "subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement." *Id.*

Examining the telephone directory at issue, this Court concluded that it was not copyrightable. Neither the facts in the directory nor their selection and arrangement met the standards of copyrightability the Court had established. The Court first held that the listings of the names, towns, and telephone numbers were pre-existing, unoriginal and therefore uncopyrightable facts. *Id.* at 361. The Court next looked at the selection of the facts in the directory and concluded that it too failed to satisfy the requirements of originality. The Court found that the telephone utility had selected and published "the most basic information—name, town, and telephone number—about each person who applies to it for telephone service." *Id.* at 362. While useful, the Court held that the utility's "selection of listings could not be more obvious," and thus fell short of meeting the minimal level of creativity. *Id.* Moreover, the Court determined that since the utility was required to publish such listings as part of its monopoly over local phone service, the utility "did not truly 'select' to publish" the listings it included in its telephone directory. Instead, the selection "was dictated by state law, not by [the utility]." *Id.* at 363.

The Tenth Circuit, consistent with the precedent of this Court, refused to apply a supersubstantial similarity test to

all fact-based works. Citing *Harper & Row*, it held that because fact-based works differ as to the amount of original or creative expression they contain, "the quantum of similarity required to establish infringement differs in each case." *Jacobsen*, 287 F.3d at 944, citing *Harper & Row*, 471 U.S. at 563. Accordingly, the Tenth Circuit concluded that Dr. Jacobsen could prove substantial similarity with less similarity than required in a case involving a telephone directory. The Tenth Circuit's holding is not inconsistent with *Feist* and is entirely consistent with *Harper & Row* on this issue.

Petitioners read *Feist* to require a court to make a threshold effort to "abstract" the unprotected facts or ideas from a copyrighted work. Because a telephone directory such as that at issue in *Feist* is made up entirely of facts, which in and of themselves are not copyrightable, the abstraction of all the unprotected elements of a factual compilation would require removing all elements of the copyrighted work. Rather than reaching this nonsensical result, the Court in *Feist* looked broadly at the arrangement and selection of the unprotected facts to determine what elements of the copyrighted work were protected. Consistent with *Feist*, the Tenth Circuit examined the two works at issue to determine whether the *Children of the Promise* series was "so similar" to Dr. Jacobsen's memoir that it could reasonably conclude that Hughes unlawfully appropriated Dr. Jacobsen's protected expression. Because it found that Hughes had copied verbatim entire passages and portions of *Who Refused to Die*, the Tenth Circuit held that there was sufficient evidence that a jury should be allowed to determine whether the works are substantially similar. The Tenth Circuit's decision to not first "abstract" all unprotected elements of *Who Refused to Die* is consistent with *Feist*.

Because the Tenth Circuit's decision in not in conflict with either, and, in fact, is entirely consistent with both, the Court's decisions in *Harper & Row* and *Feist*, Petitioners' petition for writ of *certiorari* should be denied.

B. The Tenth Circuit's Decision Is Consistent With Decisions Of The Ninth Circuit And Other Circuits.

Petitioners argue that the Tenth Circuit's decision in this matter is in direct conflict with the decisions of other circuits. In fact, the Tenth Circuit's decision is consistent with the decisions of other circuits that have dealt with the issue of the copyrightability of factual works.

Initially, it should be noted that Petitioners' primary argument, that the Tenth Circuit's decision held that a claim for copyright infringement claim involving a historical, factual work "may proceed" even "where the appropriation of expressive elements (if any) is incidental," is a straw man. In fact, the Tenth Circuit made no such limited holding. The Tenth Circuit provided several examples demonstrating the type of wrongful appropriation conducted by Hughes in writing the *Children of the Promise* series. The Tenth Circuit specifically stated that it was not necessary to its decision to provide an exhaustive list of all the protected material of Dr. Jacobsen's memoir that a jury could find to have been appropriated by Hughes. *Jacobsen*, F.3d 287 at 945. It is disingenuous for Petitioners to argue that the example provided by the Tenth Circuit in the body of its opinion is the sole incident of copying it found when comparing the works at issue in this case.[4]

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4. As noted above, the Tenth Circuit cites several other examples of verbatim copying in footnotes in its opinion. Additionally, Dr. Jacobsen in his Complaint and briefs submitted to the lower courts cites several lengthy examples of essentially verbatim copying.

Petitioners argue that the Tenth Circuit opinion is in direct conflict with the Ninth Circuit's decision in *Narell v. Freeman*, 872 F.2d 907 (9th Cir. 1989). Petitioners are mistaken. As the Tenth Circuit correctly held, the facts of the present action are readily distinguishable from those at issue in *Narell*.

In *Narell*, the Ninth Circuit held that the copying of numerous isolated phrases did not constitute infringement. The copyrighted work at issue was a nonfictional work describing the history of Jews in the San Francisco Bay Area. The defendant admitted in deposition that she had copied both historical facts and "language" from the copyrighted work. In affirming summary judgment in favor of the defendant, the Ninth Circuit held that nothing that was copied constituted protected expression.

Key to the Ninth Circuit's holding was its finding that the defendant merely copied ordinary isolated phrases and did not take a "***sequence of creative expression***" from plaintiff's copyrighted work. *Id.* at 911, quoting *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1990). The distinction between "an ordinary phrase" and a "sequence of creative expression" was explained by the Second Circuit in *Salinger* as follows:

> Though a cliché or an "ordinary" word-combination by itself will frequently fail to demonstrate even the minimum level of creativity necessary for copyright protection, such protection is available for the "association, presentation, and combination of the ideas and thought which go to make up the [author's] literary composition." Or as we have more recently stated, "What is

> protected is the manner of expression, the author's analysis or interpretation of events, the way he structures his material and marshals facts, his choice of words and the emphasis he gives to particular developments." The "ordinary" phrase may enjoy no protection as such, but its use in a sequence of expressive words does not cause the entire passage to lose protection. And though the "ordinary" phrase may be quoted without fear of infringement, a copier may not quote or paraphrase the sequence of creative expression that includes such a phrase.

Id. at 98 (internal citations omitted).

This approach is consistent with this Court's decision in *Fiest*, which made quite clear that a compilation of non-protectible elements can enjoy copyright protection even though its constituent elements do not. In *Apple Computer, Inc. v. Microsoft Corp.*, 779 F. Supp. 133 (N.D. Cal. 1991), the district court explained this approach another way:

> Suppose defendant copied plaintiff's abstract painting composed entirely of geometric forms arranged in an original pattern. The alleged infringer could argue that each expressive element (i.e., the geometric forms) is unprotectible under the functionality, merger, scenes a faire, and unoriginality theories and, thus, all elements should be excluded prior to the substantial similarity of expression analysis. Then, there would be nothing left for purposes of determining substantial similarity of expression. In this example, elimination of "unprotectible" elements

> would result in a finding of no copyright infringement, which would be clearly inconsistent with the copyright law's purpose of providing incentives to authors of original works.

Id. at 136.

Petitioners allege that Hughes merely copied "isolated phrases" from Dr. Jacobsen's memoir. *See* Pet. Brief at p. 14. As shown above, Petitioners misstate the record. They argue because Hughes in some instances did not copy the entire quotation but rather copied such "commonplace" phrases as "use any means," "get paid for your troubles," and "get off the ship," Hughes copying is not actionable. As demonstrated above, *Narell* does not support Petitioners' argument. If Hughes had merely copied these "commonplace" phrases in isolation from one another, Dr. Jacobsen likely would have no claim. A reading of the example provided by the Tenth Circuit clearly demonstrates, however, that the phrases were not, as Petitioners allege, copied by Hughes in isolation. Hughes copied each of the phrases in sequence to one another and therefore appropriated Dr. Jacobsen's creative expression. The Tenth Circuit's reading of *Narell* is entirely consistent with the holding of the Ninth Circuit.

Petitioners next argue that the Tenth Circuit's decision conflicts with the Second Circuit's decisions in *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966) and *Hoehling v. Univeral City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980). Petitioners rely on *Rosemount Enterprises* for its finding that a book which copied two direct quotations and one eight-line paraphrase from three articles about the life of Howard Hughes doubtfully constituted a substantial part of either of the articles or of the book.

Apparently, the inference that Petitioners urge the Court to draw from the *Rosemount Enterprises* decision is that the example provided by the Tenth Circuit in its opinion is insufficient to demonstrate that the material Hughes appropriated from *Who Refused to Die* constitutes a substantial part of either the *Children of the Promise* series or *Who Refused to Die*. Petitioners' reliance on *Rosemount Enterprises* is misplaced. Nowhere in its decision does the Tenth Circuit state that the example it provides is the sole instance of copying by Hughes of Dr. Jacobsen's memoir. Again, the undisputed evidence from Hughes' own deposition in this case clearly establishes that Hughes copied a significant portion of *Who Refused to Die*, including "whole chapters." As Deseret Book admits, Hughes took the "best stories" from Dr. Jacobsen's manuscript. Moreover, as the Tenth Circuit noted in its decision, "a taking may not be excused merely because it is insubstantial with respect to the *infringing* work." *Jacobsen*, 287 F.3d at 945, quoting *Harper & Row*, 471 U.S. at 565. It is irrelevant that the material Hughes copied from *Who Refused to Die* may have constituted an unsubstantial portion of the entire *Children of the Promise* series. The Tenth Circuit's decision does not conflict with *Rosemount Enterprises*.

Petitioners correctly note that the Second Circuit held in *Hoehling* that while facts are not copyrightable, the "author's original expression of particular facts" is. *Hoehling*, 618 F.2d at 974. The Second Circuit also held in *Hoehling* that "verbatim reproduction of another work . . . even in the realm of nonfiction, is actionable as copyright infringement." *Id.* at 980. Accordingly, the Second Circuit held that only "***random*** duplications of phrases and sequences of events" are not copyrightable. *Id.* at 979 (emphasis added).

The Tenth Circuit's decision is entirely consistent with *Hoehling*. The Tenth Circuit found that Hughes copied Dr. Jacobsen's original expression of particular facts verbatim. At a minimum, there were sufficient allegations of such copying to overcome the motion to dismiss. As noted in the discussion regarding *Narell* above, Hughes copying of phrases and sequences of events from Dr. Jacobsen's memoir were not found by the Tenth Circuit to be either isolated or random. The Tenth Circuit found evidence that Hughes appropriated sequences of Dr. Jacobsen's creative expression.

Petitioners ignore the Second Circuit's decision in *Salinger*, which was made several years after both *Hoehling* and *Rosemont Enterprises* and which specifically and thoroughly discusses the issue of the copyrightability of factual works. In *Salinger*, the plaintiff J.D. Salinger, who wrote *Catcher in the Rye*, brought a copyright infringement claim against the publisher of an unauthorized biography of Salinger and its author, Hamilton. Important sources of material for the biography were several unpublished letters Salinger wrote to his friends. Salinger received an initial version of the biography and demanded that quotations of his unpublished letters that appeared in the version be deleted. The biography was published with much of the material previously quoted from Salinger's unpublished letters replaced by paraphrasing. The district court found against *Salinger*.

On appeal, the Second Circuit reversed the district court's finding that the extent of copying of expressive material entitled to copyright protection was "minimal." The district court had based its holding on its finding that Hamilton's copying of Salinger's letters was fragmented and that

Hamilton merely "employ[ed] a cliché or a word-combination that is so ordinary that it does not qualify for the copyright law's protection." *Id.* at 98. Applying the law quoted above, the Second Circuit disagreed and held:

> In almost all of those instances where the quoted or paraphrased passages from Salinger's letters contain an "ordinary" phrase, the passage as a whole displays a sufficient degree of creativity as to sequence of thoughts, choice of words, emphasis, and arrangement to satisfy the minimal threshold of required creativity. And in all of the instances where that minimum threshold is met, the Hamilton paraphrasing tracks the original so closely as to constitute infringement.

Id.

The Second Circuit's holding in *Salinger* is consistent with *Narell* and *Hoehling*. Unlike those cases where the allegedly infringing work's author was found to have merely borrowed random, isolated, "ordinary" phrases, the Second Circuit found in *Salinger* that the infringing author copying the original author's sequence of creative expression. The Tenth Circuit's decision in this case is consistent with *Salinger*. The Tenth Circuit found that the evidence demonstrates that Petitioners copied more than a few words or isolated phrases from Dr. Jacobsen's memoir. Rather, Hughes copied verbatim entire passages from *Who Refused to Die*. *Jacobsen*, 287 F.3d at 97.

Finally, Petitioners argue that the Tenth Circuit's decision is in conflict with the Seventh Circuit's decision in *Nash v. CBS, Inc.*, 899 F.2d 1537 (7th Cir. 1990). Petitioners cite

Nash for its holding that the allegedly infringing author's merely used the original work "as a source of facts and ideas, to which they added their distinctive overlay." *Id.* at 1543. Petitioner's admit, however, that *Nash* involved a claim for the alleged appropriation of a plot line only. There was no evidence presented to the Court of any amount of verbatim copying. Petitioners' reliance on *Nash* is misplaced. Petitioners can point to nothing in the Seventh Circuit's opinion that is in conflict with the Tenth Circuit's decision in this case.

Petitioners conclude their argument by making the following statement: "All of these cases establish that an author is permitted to engage in incidental appropriation of expressive elements from a historical, factual work." Pet. Brief at p. 16. Petitioners' statement is not supported by the holdings of any of the cases upon which they rely. The cases cited by Petitioners uniformly hold that while facts are not copyrightable, the author's original expression of those facts is entitled to copyright protection. *Hoehling* and *Narell* do state that random, isolated "ordinary" phrases are not entitled to copyright protection. As *Salinger* clearly establishes, however, the combination of even "ordinary phrases" in a "sequence of creative expression" constitutes original expression that is entitled to copyright protection. Here, Hughes' appropriation was much more than "incidental." The Tenth Circuit's decision found evidence that Petitioners copied more than a few words or phrases and instead copied verbatim passages containing Dr. Jacobsen's original expression from *Who Refused to Die*. The Tenth Circuit's decision in not in conflict with the cases cited by Petitioners. Petitioners petition should therefore be denied.

C. The Question Presented Is Not A Recurring One of Exceptional Importance.

As demonstrated above, the question presented by Petitioners for their request for certiorari is not a recurring question on which there is any disagreement among circuits that merits this Court's attention. The Tenth Circuit's decision is consistent with this Court's precedent and the decisions of the other circuits that have addressed the issue of the copyrightability of historical works.

Moreover, this case has not progressed to trial and final judgment. The Tenth Circuit's decision recognized the preliminary nature of this action and correctly held that the *Children of the Promise* series contains enough material for a trier of act to find verbatim copying of Dr. Jacobsen's original expression and that Dr. Jacobsen could, therefore, prove a set of facts entitling him to relief. Accordingly, a jury should be allowed to determine whether the works at issue are substantially similar.

The question presented by Petitioners in their Petition for Writ ignores the fact that examples provided by the Tenth Circuit were not an exhaustive list and merely constituted a threshold finding that reflected the preliminary nature of the case. The question is not of exceptional importance. The Court should therefore decline to accept certiorari.

CONCLUSION

For the foregoing reasons, this Court should deny the petition for a writ of certiorari.

Respectfully submitted,

BRENT O. HATCH
Counsel of Record
MARK H. RICHARDS
HATCH, JAMES & DODGE
Attorneys for Respondent
10 West Broadway
Suite 400
Salt Lake City, Utah 84101
(801) 363-6363

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IN THE
Supreme Court of the United States
OCTOBER TERM, 2002

DESERET BOOK COMPANY; DEAN HUGHES,

Petitioners,

v.

GENE S. JACOBSEN,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Tenth Circuit

REPLY TO BRIEF IN OPPOSITION

KENNETH W. STARR
KANNON K. SHANMUGAM
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, DC 20005
(202) 879-5000

MARY ANNE Q. WOOD
Counsel of Record
KATHRYN O. BALMFORTH
WOOD CRAPO LLC
500 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
(801) 366-6060

[*additional counsel on inside cover*]

November 12, 2002

13 pp

RICHARD G. WILKINS*
J. Reuben Clark Law School
513 J. Reuben Clark Building
Brigham Young University
Provo, UT 84602
(801) 422-2669

KENT B LINEBAUGH
JONES, WALDO, HOLBROOK
& MCDONOUGH
170 South Main Street
Salt Lake City, UT 84101
(801) 521-3200

* *affiliation given for associational purposes only*

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES ii

INTRODUCTION 1

I. The Tenth Circuit Based Its Holding As To Substantial Similarity On Only Minimal, If Any, Appropriation Of Expressive Elements 1

II. Respondent Fails To Distinguish The Cases On Which Petitioners Rely 3

III. The Procedural Posture Of This Case Is No Bar To Review 7

CONCLUSION 9

TABLE OF AUTHORITIES

Page

Cases

Feist Publications, Inc. v. Rural Telephone Service Co.,
499 U.S. 340 (1991) 2-3, 5

Buck v. Jewell-La Salle Realty Co.,
283 U.S. 191 (1931) 6-7

Harper & Row, Publishers, Inc. v. Nation Enterprises,
471 U.S. 539 (1985) 4, 5

Hoehling v. Universal City Studios, Inc.,
618 F.2d 972 (2d Cir.),
cert. denied, 449 U.S. 841 (1980) 6, 8

Narell v. Freeman,
872 F.2d 907 (9th Cir. 1989) 5, 8

Nash v. CBS, Inc.,
899 F.2d 1537 (7th Cir. 1990) 7, 8

Rosemont Enterprises, Inc. v. Random House, Inc.,
366 F.2d 303 (2d Cir. 1966),
cert. denied, 385 U.S. 1009 (1967) 6, 8

Salinger v. Random House, Inc.,
811 F.2d 90 (2d Cir. 1987) 7

Wal-Mart Stores, Inc. v. Samara Brothers, Inc.,
529 U.S. 205 (2000). 8

Warner Bros. Inc. v. American Broad. Cos.,
720 F.2d 231 (2d Cir. 1983) 8

INTRODUCTION

In his opposition, respondent seeks to avoid the bedrock reality presented by the Tenth Circuit's opinion: certainty and clarity are vitally needed in this burgeoning area of litigation. Certainty and clarity in the operative rules of copyright are not only important for our system of free expression, but also of vast commercial significance. Ideas, information, and creative expression increasingly constitute important forms of property. The Tenth Circuit's decision, which allows respondent's claim of infringement of his copyrighted historical work to proceed on the basis of only minimal, if any, appropriation of expressive elements, would not only destabilize the law, but also have a substantial chilling effect on authors and publishing houses alike.

I. The Tenth Circuit Based Its Holding As To Substantial Similarity On Only Minimal, If Any, Appropriation Of Expressive Elements.

In order to play down the inconsistency between the Tenth Circuit's decision and earlier decisions of this Court and other courts of appeals, respondent devotes a substantial portion of his brief in opposition to recharacterizing what the Tenth Circuit actually held.[1] Respondent's dogged efforts notwithstanding, however, it is clear that the Tenth Circuit held that a subsequent work could be sufficiently "similar" to a copyrighted historical work

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[1] In an effort to cast petitioners in the worst equitable light, respondent also makes a number of factual representations regarding how he learned of petitioners' use of his story in the *Children of the Promise* series, including representations regarding what happened at a 1994 meeting between respondent and petitioner Hughes. *See* Opp. 1-4. As the district court and Tenth Circuit both noted, however, "what happened at the meeting and thereafter is heavily disputed by the parties." Pet. 18a, 31a. Petitioners continue hotly to contest the accuracy of respondent's representations. Even assuming they are true, however, they are legally irrelevant here because they relate only to the Tenth Circuit's ruling that respondent's claims were not barred by laches—a ruling that is not before this Court on *certiorari*.

even where the appropriation of expressive elements, if any, is minimal.

Respondent attempts to recast the Tenth Circuit's opinion in two principal ways. *First*, respondent suggests that the Tenth Circuit based its ruling on "*several lengthy examples* * * * of verbatim copying by Petitioners." Opp. 1 (emphasis added). Indeed, this characterization pervades respondent's brief. *See id.* at 5, 8, 14, 15, 17, 18, 22, 24, 25, 26. As noted in the petition, however, the Tenth Circuit in fact cited only *one* example of verbatim copying—involving a passage of respondent's memoir in which he described his journey to unite with American troops after the end of World War II. *See* Pet. 7-8. Indeed, even as to the passage in question, the Tenth Circuit stated only that the passage *might* contain protected expression—not that it actually did. *See id.* at 14a.

It is true, as respondent points out, that the Tenth Circuit, in a series of footnotes, quoted three other parallel passages in which the two works at issue recounted similar events. *See id.* at 10a n.7; *id.* at 11a n.8; *id.* at 12a n.9. Contrary to respondent's suggestion, however, the Tenth Circuit did not "f[i]nd that *in many instances* Hughes copied *verbatim* whole passages * * * from Dr. Jacobsen's memoir." Opp. 8 (first emphasis added). To the contrary, the Tenth Circuit listed these three passages only as examples of "paraphrasing," not verbatim copying, *see* Pet. 12a, and ultimately rested its conclusion on substantial similarity *solely* on the single example of verbatim copying, not on any of the examples of paraphrasing, *see id.* at 15a.

Second, respondent suggests that the Tenth Circuit concluded that petitioners appropriated respondent's protected expression by copying the *arrangement* of otherwise unprotected language. *See* Opp. 21, 23. To be sure, this Court has held that a factual compilation can be entitled to copyright protection to the extent that the facts are arranged in an original manner. *See Feist*

Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 348-49 (1991). Even assuming, however, that respondent could claim originality in what was ostensibly a chronological arrangement of historical facts, *cf. id.* at 363 (rejecting claim of originality in alphabetical arrangement of names in telephone directory), the Tenth Circuit said nothing about the *arrangement* of the language that was allegedly copied verbatim. Instead, it based its holding as to substantial similarity entirely on its conclusion, drawn from the single example cited in the opinion, that petitioners "*arguably* copied *more than a few* words and phrases." Pet. 14a (emphasis added).

In sum, the Tenth Circuit allowed respondent's claim to proceed solely because petitioners allegedly copied words and phrases from a single brief passage in the copyrighted work—words and phrases which themselves were arguably not even protected expression. The Tenth Circuit's holding—that a subsequent work could be sufficiently "similar" to a copyrighted historical work even where the appropriation of expressive elements, if any, is minimal—is in tension with this Court's prior decisions and conflicts with decisions of other courts of appeals.

II. Respondent Fails To Distinguish The Cases On Which Petitioners Rely.

Respondent does not, because he cannot, challenge the fact that this Court has frequently granted *certiorari* on important issues of copyright law even where there is no direct circuit conflict. *See* Pet. 2, 13. Nor does he challenge the importance of the question presented. *See id.* at 16-17. Instead, he contends only that the Tenth Circuit's decision is not in tension with this Court's prior decisions or in conflict with decisions of other courts of appeals. To a large extent, respondent's arguments depend on his recharacterization of what the Tenth Circuit actually held. *See, e.g.*, Opp. 14-15 (asserting that "[t]he Tenth Circuit's decision is not in conflict with *Harper & Row*" because "[t]he Tenth Circuit found

evidence demonstrating that Hughes copied verbatim *significant portions* of Dr. Jacobsen's individualized expression" and because "it found that Hughes copied *entire passages and portions* of Dr. Jacobsen's memoir") (emphasis added). To the extent they do not, however, respondent's arguments still fail.

Respondent begins by contending that the Tenth Circuit's decision is consistent with this Court's prior decisions in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), and *Feist*. As to *Harper & Row*, respondent remarkably asserts that "nothing in the decision requires a court to 'abstract' the unprotected facts from the protected expression of a copyrighted work." Opp. 14. To be sure, in *Harper & Row*, this Court did not specify a particular *method* for distinguishing unprotected fact from protected expression: indeed, the Court expressly noted that, "[e]specially in the realm of factual narrative, the law is currently unsettled regarding the ways in which uncopyrightable elements combine with the author's original contributions to form protected expression." 471 U.S. at 548. Nowhere, however, did either the majority or dissenting opinion suggest that a reviewing court should make *no* effort to separate unprotected fact and protected expression. *See, e.g., Harper & Row*, 471 U.S. at 582 (Brennan, J., dissenting) (noting that "infringement of copyright must be based on a taking of literary form, as opposed to the ideas or information contained in a copyrighted work"). Because the Tenth Circuit merely searched the two works for examples of *verbatim copying*, without making any effort to identify *protected expression*, its decision is in tension with *Harper & Row*.[2]

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[2] Respondent also points out that Justice Brennan, in concluding in his *Harper & Row* dissent that there was no substantial similarity, relied heavily on the facts that the allegedly infringing work did not *paraphrase* substantial portions of the copyrighted work and that the allegedly infringing work did not *arrange* the information presented in the same order. *See* Opp. 12-13. Petitioners are not contending, however, that the Tenth

(continued...)

As to *Feist*, respondent contends that "[p]etitioners argue that *Feist* establishes that in the context of all factual works, only verbatim * * * copying of the author's original expression gives rise to a claim of copyright infringement." Opp. 15. As petitioners have already acknowledged, however, *see* Pet. 11, this Court expressly recognized in *Feist* that, even absent the addition of original expression to underlying facts, an entirely factual compilation could be protected to the extent that facts are arranged in an original manner, *see* 499 U.S. at 348-49. It is therefore not true, as respondent wrongly accuses petitioners of claiming, that the *only* way a work can receive copyright protection is if unprotected facts are "abstracted" and protected expression remains. However, where, as here, the reviewing court does not conclude that a work is protected because it contains an original *arrangement* of unprotected material, the court must make some effort to *identify* protected expression. Because the Tenth Circuit failed to make that effort, its decision is in tension with *Feist*.

Respondent's efforts to distinguish the court of appeals cases on which petitioners rely are no more availing. Respondent contends that the Ninth Circuit's decision in *Narell v. Freeman*, 872 F.2d 907 (1989), is somehow consistent with the Tenth Circuit's decision here because the defendant in *Narell* copied only "ordinary isolated phrases" and not a "*sequence* of creative expression" from the plaintiff's work. Opp. 19 (emphasis added). As discussed above, however, the Tenth Circuit did not rely on any

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[2] (...continued)
Circuit's decision is inconsistent with Justice Brennan's dissent in either of these respects, since the Tenth Circuit did not reach either of these issues. Instead, petitioners assert merely that the Tenth Circuit's opinion is inconsistent with Justice Brennan's statements, unchallenged by the *Harper & Row* majority, that mere "linguistic similarities," in and of themselves, are insufficient to give rise to infringement, *see* 471 U.S. at 585 (dissenting opinion), and that no copyright can be asserted in the verbatim representation of the quoted statements of others, *see id.* at 586 n.10.

determination that petitioners copied a particular *arrangement* of otherwise unprotected material in concluding that the works were sufficiently "similar" to give rise to a claim of infringement. Indeed, to the extent that respondent contends that the arrangement of words and phrases *within the quotation* on which the Tenth Circuit relied constitutes protected expression, respondent fails even to address whether a *quotation* from another person can constitute protected expression *at all*. *See* Pet. 12-13 & n.4.

Respondent next attempts to distinguish the Second Circuit's decision in *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (1966), *cert. denied*, 385 U.S. 1009 (1967), ostensibly on the ground that the Second Circuit erroneously focused on whether the duplicated language constituted a substantial portion of the *infringing* work, rather than the *infringed* work. *See* Opp. 21-22. In fact, however, the Second Circuit stated that there was considerable doubt as to whether the duplicated language constituted a substantial portion of *either* the infringing *or* the infringed work. *See* 366 F.2d at 306. The court proceeded to find that the copying of two direct quotations and one eight-line paraphrase was insufficient evidence of infringement to warrant the entry of a preliminary injunction. *See id.* At a minimum, that determination is in tension with the Tenth Circuit's determination that the copying of isolated commonplace phrases in a *single* quotation suffices to allow a claim of infringement to go forward.

As for the Second Circuit's decision in *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 974, *cert. denied*, 449 U.S. 841 (1980), respondent feebly dismisses that case on the ground that *Hoehling* sanctioned only the "random" duplication of words and phrases, whereas the Tenth Circuit found that petitioners' copying was not random. *See* Opp. 22-23. It is clear, however, that the Second Circuit used the term "random" synonymously with "incidental," not with "non-intentional"—especially since intent is not an element of copyright infringement. *See Buck v. Jewell-La*

Salle Realty Co., 283 U.S. 191, 198 (1931). Because the Tenth Circuit's opinion relied only on incidental copying of protected material (to the extent that material was protected at all), it is in conflict with *Hoehling*.

Finally, respondent suggests that *Nash v. CBS, Inc.*, 899 F.2d 1537 (7th Cir. 1990), is entirely inapposite because it involved the alleged appropriation only of a plot line, not of particular language. *See* Opp. 24-25. That is true, as petitioners have already conceded. *See* Pet. 16. Nevertheless, Judge Easterbrook's broad reasoning in *Nash* as to the lower degree of protection given to historical works is applicable to the incidental appropriation of expressive elements, as well as the appropriation of plot lines. Respondent offers no explanation as to why this reasoning should pertain only to the latter and not the former.[3]

The Tenth Circuit's decision here is contrary to the overwhelming weight of authority, both from this Court and from other courts of appeals. *Certiorari* is therefore warranted.

III. The Procedural Posture Of This Case Is No Bar To Review.

In a final throw of the dice, respondent contends that this Court should wait for another case in which to address the question presented because this case arises in the posture of review of denial

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[3] Respondent also contends that the Tenth Circuit's decision is consistent with the Second Circuit's decision in *Salinger v. Random House, Inc.*, 811 F.2d 90 (1987). In *Salinger*, however, the Second Circuit—in the context of determining the "amount and substantiality" of the portion used for purposes of applying the *fair use doctrine*—noted that the allegedly infringing work *paraphrased* the copyrighted work so closely as to constitute infringement. *Id.* at 98. Because the Tenth Circuit here rested its conclusion on substantial similarity solely on the single passage containing verbatim copying, it expressly left open the question whether close paraphrasing can give rise to substantial similarity—citing *Salinger* in the process. *See* Pet. 15a.

of a motion to dismiss. *See* Opp. 26. Although it is true, as the Tenth Circuit recognized, that substantial similarity is ultimately a question for the jury, *see* Pet. 7a, judges are obligated to determine both whether the copyrighted work contains protected expression and, if so, whether the two works are sufficiently similar as a matter of law for the case to proceed to the jury in the first place, *see, e.g.*, *Warner Bros. Inc. v. American Broad. Cos.*, 720 F.2d 231, 245 (2d Cir. 1983) (noting that "[c]ourts have an important responsibility in copyright cases to monitor the outer limits within which juries may determine reasonably disputed issues of fact"). Indeed, all of the courts of appeals cases with which the Tenth Circuit's decision conflicts arose at the preliminary-injunction or summary-judgment stage. *See Nash*, 899 F.2d at 1539; *Narell*, 872 F.2d at 909; *Hoehling*, 618 F.2d at 977; *Rosemont Enterprises*, 366 F.2d at 304.[4] And review is particularly appropriate where, as here, the courts below had before them not only the complaint, but also the copyrighted and allegedly infringing works themselves—all that is ever required to determine whether the two works are substantially similar or not. *See* Pet. 3a-4a. There is nothing to wait for; this case is ready for this Court's review now.

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[4] Moreover, this Court recently decided a trademark case presenting a similar question in the posture of review of denial of a motion for judgment as a matter of law. *See Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 208 (2000).

CONCLUSION

For the foregoing reasons, this Court should grant the petition for writ of *certiorari*.

Respectfully submitted,

KENNETH W. STARR
KANNON K. SHANMUGAM
KIRKLAND & ELLIS
655 Fifteenth Street, N.W.
Washington, DC 20005
(202) 879-5000

RICHARD G. WILKINS*
J. Reuben Clark Law School
513 J. Reuben Clark Building
Brigham Young University
Provo, UT 84602
(801) 422-2669

** affiliation given for associational purposes only*

MARY ANNE Q. WOOD
Counsel of Record
KATHRYN O. BALMFORTH
WOOD CRAPO LLC
500 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
(801) 366-6060

KENT B LINEBAUGH
JONES, WALDO, HOLBROOK & MCDONOUGH
170 South Main Street
Salt Lake City, UT 84101
(801) 521-3200

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IN THE

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DESERET BOOK COMPANY; DEAN HUGHES,
Petitioners,

v.

GENE S. JACOBSEN,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Tenth Circuit

MOTION FOR LEAVE TO FILE BRIEF AS *AMICI CURIAE* AND BRIEF OF *AMICI CURIAE* AUTHORS GUILD, INC., ASSOCIATION OF AMERICAN PUBLISHERS AND BONNEVILLE INTERNATIONAL CORPORATION IN SUPPORT OF PETITIONERS

VON G. KEETCH*
BERNIE S. BROADBENT
ALEXANDER DUSHKU
KIRTON & MCCONKIE
A PROFESSIONAL CORPORATION
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
(801) 328-3600

CARTER G. PHILLIPS
GENE C. SCHAERR
SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, D.C. 20005
(202) 736-8000

Counsel for Amici Curiae

October 25, 2002

* Counsel of Record

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20001

22pp

IN THE

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MOTION OF AUTHORS GUILD, INC., ASSOCIATION OF AMERICAN PUBLISHERS AND BONNEVILLE INTERNATIONAL CORPORATION FOR LEAVE TO FILE BRIEF AS *AMICI CURIAE* IN SUPPORT OF PETITIONERS

Amici Curiae Authors Guild, Inc., Association of American Publishers and Bonneville International Corporation respectfully request leave of this Court to file the following brief in the above captioned manner. In support of its motion, *amici curiae* states as follows:

The petitioners have granted their consent in writing to the filing of this brief. Petitioners' written consent has been filed with this brief. However, respondent has denied consent to the filing of this brief, thus necessitating this motion.

Amici are deeply concerned about the chilling effect of the decision below on authors, publishers, broadcasters, and other members of the media. Accordingly, *amici* support the

petition for a writ of certiorari filed by Deseret Book Company and Dean Hughes, the defendants in this copyright suit.

Each of the *amici*, moreover, has a vital interest in the proper application of the copyright laws to historical materials. The Authors Guild, Inc. is a national association of more than 8,000 professional book and periodical writers of all genres, including novelists, children's book authors and illustrators, journalists, scholars, historians, biographers and other writers of fiction and nonfiction. Founded in 1912, the Guild is the oldest and largest organization of published writers in the United States. Guild members have won Nobel and Pulitzer Prizes and countless other awards and honors. Among the Guild's principal purposes are to express its members' views in cases involving the interpretation of the Copyright Act and to protect the invaluable rights the Act provides to authors. The Guild appears as *amicus curiae* supporting the Petition because the decision below threatens the work of all authors, and particularly biographers, historians and novelists who write on historical matters.

The Association of American Publishers ("AAP") is the national trade association of the book publishing industry in the United States. AAP's members include most of the major commercial book publishers in the U.S. as well as smaller and non-profit publishers, university presses, and scholarly societies. AAP members publish hardcover and paperback books and journals in every field of interest, including educational materials for the elementary, secondary, postsecondary, and professional markets, as well as computer software and multimedia products and services. AAP represents an industry whose diverse, competitive members depend for their very existence on the principled application of copyright law and the rights guaranteed by the First Amendment.

Bonneville International Corporation, a subsidiary of Deseret Management Corporation and sister corporation to

petitioner Deseret Book Company, is a leading broadcast company and owner of radio stations nationwide. Bonneville also operates KSL Television, the NBC affiliate located in Salt Lake City. Bonneville produces documentaries and, like all broadcasters, frequently repackages and broadcasts news stories taken from other sources. Accordingly, Bonneville often relies on the well established copyright principles that facts are not protectible and that *de minimis* copying of expressive elements in factual works does not work an infringement.

For the foregoing reasons, the motion for leave to file the attached brief of *amici curiae* should be granted.

Respectfully submitted,

VON G. KEETCH*
BERNIE S. BROADBENT
ALEXANDER DUSHKU
KIRTON & MCCONKIE
A PROFESSIONAL CORPORATION
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
(801) 328-3600

CARTER G. PHILLIPS
GENE C. SCHAERR
SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, D.C. 20005
(202) 736-8000

Counsel for Amici Curiae

October 25, 2002

* Counsel of Record

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
INTEREST OF THE *AMICI CURIAE*	1
REASONS FOR GRANTING THE PETITION	2
ARGUMENT	3
I. THE DECISION BELOW WILL CHILL THE CREATION OF NEW WORKS OF FACT OR FICTION, THEREBY SUBVERTING IMPORTANT INTERESTS PROTECTED BY THE FIRST AMENDMENT AND THE COPYRIGHT ACT	3
A. The Decision Below Will Have A Substantial Adverse Impact On Authors Publishers And Broadcasters	3
B. The Decision Below Will Have A Nationwide Impact In An Area Of The Law With Profound First Amendment Implications	8
II. GRANTING THE PETITION WILL HAVE THE ADDED BENEFIT OF CLARIFYING THE STATUS OF THE COPYRIGHT ESTOPPEL DOCTRINE	10
CONCLUSION	14

TABLE OF AUTHORITIES

CASES Page

Adsani v. Miller, 1996 WL 671108 (S.D.N.Y. Nov. 20, 1996), *aff'd*, 139 F.3d 67 (2d Cir. 1998) 6
Arica Inst., Inc. v. *Palmer*, 970 F.2d 1067 (2d Cir. 1992) 11
Baker v. *Selden*, 101 U.S. 99 (1879) 5
Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994) 8
Davies v. Bowes, 209 F. 53 (S.D.N.Y. 1913), *aff'd*, 219 F. 178 (2d Cir. 1914) 11
Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) 2, 3, 4, 5, 8
Greenbie v. Noble, 151 F.Supp. 45 (S.D.N.Y. 1957) 11
Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985) 4, 5, 7, 8
Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir. 1980) 4, 5, 12
Houts v. Universal City Studios, Inc., 603 F. Supp. 26 (C.D. Cal. 1984) 10
Huie v. NBC, 184 F. Supp. 198 (S.D.N.Y. 1960) 11
Lake v. CBS, Inc., 140 F. Supp. 707 (S.D. Cal. 1956) 11
Marshall v. Yates, 223 U.S.P.Q. 453 (C.D. Cal. 1983) 11
Mills Music, Inc. v. Snyder, 469 U.S. 153 (1985) 8
Mosley v. Follett, 209 U.S.P.Q. 1109 (S.D.N.Y. 1980) 11
Nash v. CBS, Inc., 899 F.2d 1537 (7th Cir. 1990) 11
Nester's Map & Guide Corp. v. Hagstrom Map Co., 796 F. Supp. 729 (E.D.N.Y. 1992) 11
New Era Publ'ns Int'l, ApS v. Henry Holt & Co., 873 F.2d 576 (2d Cir. 1989) 6

TABLE OF AUTHORITIES – continued

	Page
New York Times Co. v. Tasini, 533 U.S. 483 (2001)	8
Norse v. Henry Holt & Co., 847 F. Supp. 142 (N.D. Cal. 1994)	6
Oliver v. St. Germain Found., 41 F. Supp. 296 (S.D. Cal. 1941)	10, 11
Rokeach v. Avco Embassy Pictures Corp., 197 U.S.P.Q. 155 (S.D.N.Y. 1978)	11
Rosemont Enters., Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966)	6
Russell v. Turnbaugh, 18 U.S.P.Q.2d 1948 (D. Colo. 1991)	11
Scholastic, Inc. v. Stouffer, 2002 WL 31093616 (S.D.N.Y. Sept. 17, 2002)	6
Skinder-Strauss Assocs. v. Massachusetts Continuing Legal Educ., Inc., 914 F. Supp. 665 (D. Mass. 1995)	11
Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417 (1984)	9, 10
Suid v. Newsweek Magazine, 503 F.Supp. 146 (D.C. 1980)	11
Williamson v. Pearson Educ., Inc., 60 U.S.P.Q.2d 1723 (S.D.N.Y. 2001)	11

CONSTITUTION AND STATUTE

U.S. Const. art. I, § 8, cl. 8	7
17 U.S.C. § 102(b)	4
§ 302(a)	6
§ 303(a)	6

OTHER AUTHORITIES

Press Release, Publishers Weekly (July 15, 2002)	7
1 M. Nimmer & D. Nimmer, *Copyright* (2000)	10

TABLE OF AUTHORITIES – continued

Page

Tad Crawford & Kay Murray, *The Writer's Legal Guide: An Author's Desk Reference* (3d ed. 2002) 7

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BRIEF OF AUTHORS GUILD, INC., ASSOCIATION OF AMERICAN PUBLISHERS AND BONNEVILLE INTERNATIONAL CORPORATION AS *AMICI CURIAE* IN SUPPORT OF PETITIONERS

INTEREST OF THE *AMICI CURIAE*[1]

The interests of the Authors Guild, Inc., Association of American Publishers and Bonneville International Corporation are set forth in the accompanying motion for leave to file as *amici curiae*.

[1] Counsel for *amici* state that they authored this brief in whole and that no person or entity, other than *amici*, made a monetary contribution to the preparation or submission of this brief.

REASONS FOR GRANTING THE PETITION

It is axiomatic that facts and ideas cannot be copyrighted, but may be freely used to create new works of fact or fiction. Accordingly, for centuries, biographers, historians and historical novelists have drawn heavily from primary and secondary source material – including letters, diaries, published and unpublished memoirs, and biographies – as the building blocks of their own works. Writers, publishers, and broadcasters turn these primary sources into literature and film. In so doing, they help the public digest, understand, and learn from the past.

In short, writers, publishers, and broadcasters cannot do their work credibly without drawing from the vast store of existing knowledge contained in prior works. Copyright law has long protected their ability to do so.

As the Petition explains, however, the Tenth Circuit has now held that an author may be found liable for copyright infringement merely because a jury could find that factual elements in a fictional work bear "too close" a resemblance to factual elements in a copyrighted factual work. As shown in the petition and discussed more fully below, this holding conflicts with established principles of copyright law. If not reversed, that holding will have disastrous consequences for the entire publishing and broadcasting industry.

Indeed, because copyright standards set by individual courts of appeals effectively govern nationwide, the decision below will inhibit the creation of important new works throughout the country. It will deter authors, publishers, and broadcasters from using facts contained in historical sources for the creation of new works of literature and televised works such as historical and biographical documentaries. Thus, the Tenth Circuit's decision thwarts a central purpose of the Copyright Act and the First Amendment – to promote the dissemination of facts and "encourage[] others to build freely upon the ideas and information conveyed by a work." *Feist*

Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349-50 (1991).

ARGUMENT

I. THE DECISION BELOW WILL CHILL THE CREATION OF NEW WORKS OF FACT OR FICTION, THEREBY SUBVERTING IMPORTANT INTERESTS PROTECTED BY THE FIRST AMENDMENT AND THE COPYRIGHT ACT.

The Petition well explains the importance of the question presented in this case, as well as the tension the opinion below creates with prior decisions of this Court and the outright conflict with decisions of the other Courts of Appeals. Simply stated, facts cannot be copyrighted and, therefore, a *de minimis* appropriation of expressive elements from a copyrighted factual work does not give rise to a claim for infringement. Pet. at 9-13.

The Tenth Circuit's contrary holding creates serious uncertainty for authors, publishers, and broadcasters. Accordingly, the decision below will chill the creation of new literature and productions that rely on and draw from existing histories, biographies, memoirs, and other factual accounts. In so doing, the decision will have a nationwide impact in an area of the law with profound First Amendment implications.

A. The Decision Below Will Have A Substantial, Adverse Impact On Authors, Publishers And Broadcasters.

There can be no doubt that the decision below conflicts, at least in principle, with decisions of this Court and of various courts of appeals. As this Court put it in the leading decision of *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), "The most fundamental axiom of copyright law is that '[n]o author may copyright his ideas or the facts he narrates.'" *Id.* at 344-45 (alteration in original)

(quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985)); *see* 17 U.S.C. § 102(b). As the Court also noted, "facts are not copyrightable" because "[t]o qualify for copyright protection, a work must be original to the author." *Feist*, 499 U.S. at 345. Moreover, "[t]he *sine qua non* of copyright is originality." *Id.*

Accordingly, as this Court has held, "'[n]o one may claim originality as to facts'" because "facts do not owe their origin to an act of authorship." *Id.* at 347 (quoting 1 M. Nimmer & D. Nimmer, *Copyright* § 2.11[A] (1990)). Instead, "infringement of copyright must be based on a taking of literary form, as opposed to the ideas or information contained in a copyrighted work." *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 582 (1985) (Brennan, J., dissenting). Thus, "'no matter how much original authorship [a] work displays, the facts and ideas it exposes [as opposed to original expression] are free for the taking.'" *Feist*, 499 U.S. at 349 (quoting Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 Colum. L. Rev. 1865, 1868 (1990)).

It follows that, "[n]otwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work" provided that original expression is not copied. *Id.* Indeed, as the Second Circuit has held, "[i]n works devoted to historical subjects, it is our view that a second author may make significant use of prior work, so long as he does not bodily appropriate the expression of another." *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2d Cir. 1980).

1. The traditional demarcation between unprotected facts and protected expression is indispensable for authors, publishers, and broadcasters whose works rely upon or draw from the historical works of others. Justice Brennan aptly noted that, "[w]ere an author able to prevent subsequent authors from using concepts, ideas, or facts contained in his or her work, the creative process would wither and scholars

would be forced into unproductive replication of the research of their predecessors." *Harper & Row*, 471 U.S. at 582 (Brennan, J., dissenting); *see Hoehling*, 618 F.2d at 979.

Indeed, as this Court put it in an early decision, "The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book." *Baker v. Selden*, 101 U.S. 99, 103 (1879). That is why the law leaves "a subsequent compiler . . . free to use the facts contained in another's publication to aid in preparing a competing work." *Feist*, 499 U.S. at 349.

Of course, the "[c]reation of a nonfiction work, even a compilation of pure fact, entails originality." *Harper & Row*, 471 U.S. at 547. There is no doubt that large amounts of original (and thus copyrightable) expression go into the creation of, for example, a biography or documentary, even though the work as a whole may be completely factual in nature. Accordingly, to encourage originality by writers of *both* history and fiction, "copyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original . . . as long as such use does not unfairly appropriate the author's original contributions." *Id.* at 548.

The Tenth Circuit's ruling strips that critical latitude out of the law, with palpable chilling effects on authors, publishers and broadcasters nationwide.

2. The *amici* are particularly concerned about the threat the decision poses to biographers, historians, and novelists who write on historical matters, as well as those who publish such works. The decision below introduces widespread uncertainty among authors and publishers by sharply narrowing the traditionally broad latitude the law has afforded

to the copying of facts contained in diaries, letters, memoirs and other unpublished materials.[2]

This is particularly problematic because many claims of copyright infringement are made against authors and publishers of serious works that use facts from letters, diaries, or even the life stories of their subjects. Some of these suits are specifically intended to control the public's access to information about the persons portrayed. *See, e.g., New Era Publ'ns Int'l, ApS v. Henry Holt & Co.*, 873 F.2d 576 (2d Cir. 1989) (Church of Scientology challenged critical biography of founder L. Ron Hubbard); *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966). Thus, the issue embraced by the question presented – what, exactly, amounts to illegal copying of factual elements in works such as histories, biographies and memoirs – is a recurring issue of grave import.

The chilling effect of such suits on research, writing, and publishing is very real. Even the most frivolous of infringement lawsuits can last years in federal court and cost hundreds of thousands of dollars in attorneys fees. *See Scholastic, Inc. v. Stouffer*, 2002 WL 31093616 (S.D.N.Y. Sept. 17, 2002) (meritless suit claiming author of Harry Potter series infringed prior works dismissed with prejudice after two years); *Adsani v. Miller*, 1996 WL 671108 (S.D.N.Y. Nov. 20, 1996) (meritless infringement action dismissed after four years of litigation), *aff'd*, 139 F.3d 67 (2d Cir. 1998); *Norse v. Henry Holt & Co.*, 847 F. Supp. 142 (N.D. Cal. 1994) (two years). Prolonged litigation can decimate the

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[2] Copyright law protects any unregistered, unpublished writing until at least the end of 2002. *See* 17 U.S.C. § 303(a). If the previously unregistered, unpublished work is published before the end of this year, copyright will not expire until December 31, 2047. For writings that were registered, such as that of Respondent Jacobsen, copyright protects against their use by others until 70 years after the author's death. *Id.* §§ 302(a), 303(a).

financial resources of individual authors and all but the largest of publishers.

With respect to authors, moreover, this threat is direct and personal. Most published authors are contractually liable to their publishers, pursuant to the warranties and indemnification clauses included in virtually all publishing contracts, for all costs – including attorneys' fees – stemming from any claim. This indemnity obligation typically applies regardless of the claim's legal and factual merit.[3]

The certain increase in such claims as a direct result of the Tenth Circuit's decision will necessarily stifle not just the publication of new literary works, but the very use of primary sources. The uncertainty increases the risk and thus the cost of publishing new works. This, in turn, decreases the number of publications, thereby subverting the very purpose for which Congress was given the power to grant copyrights. As this court has said, "copyright [law] is intended to increase and not to impede the harvest of knowledge." *Harper & Row*, 471 U.S. at 545; *see also* U.S. Const. art. I, § 8, cl. 8 ("the Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries"). If allowed to stand, the decision below will undermine these basic copyright and constitutional values by deterring the creation of new works.

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[3] The fact that many publishers include the author's work under their media liability insurance coverage does not cure the chilling effect. Tad Crawford & Kay Murray, *The Writer's Legal Guide: An Author's Desk Reference* 160 (3d ed. 2002). In such cases, publishing contracts normally provide that the author must cover the publisher's defense costs to the extent of the deductible – typically $50,000 to $250,000 or higher. Random House, the nation's largest publisher, recently announced that the deductible on its coverage has been increased from $100,000 to $1 million. Press Release, Publishers Weekly (July 15, 2002). Many small publishers cannot afford media liability policies.

3. Broadcasters' activities will likewise be chilled by the decision below. Documentaries and other productions often draw from histories, biographies, memoirs, and other factual sources, raising all the risks identified above. Given the limits on primary fact-gathering capacities, broadcast news segments frequently rely upon the repackaging of existing news stories taken from other media outlets. Given that fact, and given the lightening-fast news cycle, *de minimis* copying of original expression about factual matters contained in other copyrighted news sources is virtually unavoidable.

Heretofore, such *de minimis* copying had never been thought to create a significant risk of liability. The Tenth Circuit's decision, however, subjects broadcasters to that very risk.

B. The Decision Below Will Have A Nationwide Impact In An Area Of The Law With Profound First Amendment Implications.

The need for this Court's review is heightened by the nationwide impact of any significant Court of Appeals decision in this sensitive area. As many leading copyright decisions confirm, this Court has often granted *certiorari* to review rulings of the Courts of Appeals that disrupt settled copyright doctrines or practices in publishing and related industries, even absent an unambiguous circuit conflict.[4] This

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[4] *See New York Times Co. v. Tasini*, 533 U.S. 483 (2001); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (holding that musical parody constitutes "fair use"; petitioner alleged only a conflict in principle over treatment of musical parodies); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (holding that telephone white pages are not copyrightable if they lack original "selection, coordination, or arrangement"; petitioner alleged only a conflict in principle over "sweat of the brow doctrine"); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985) (holding that use of quotations from unpublished memoirs is not protected "fair use"; petitioner alleged only a conflict in principle over fair use doctrine); *Mills Music, Inc. v. Snyder*, 469 U.S. 153 (1985) (holding that publisher was entitled to share in royalties from

Court's prompt intervention in such cases is both necessary and proper, for two reasons.

First, the publishing industry is somewhat unique in that a decision of a single circuit can effectively require a publisher to alter its practices throughout the nation. The copyright law of the Tenth Circuit, for example, governs authors and publishers in all of the other circuits and indeed throughout the rest of the world if their works are to be distributed in the Tenth Circuit, just as it governs authors and publishers in the Tenth Circuit whose works are intended for distribution to readers throughout the nation or world. Thus, a decision (like that below) which sets an aberrant standard expanding the liability of authors, publishers, and broadcasters has a chilling effect nationwide.

This chilling effect is exacerbated in today's world of instant transmission and Internet capability. Publishers and authors can no longer be certain where their works will be transmitted or distributed. Accordingly, to be relatively certain that it is complying with governing copyright law, a publisher or author must always meet the "highest common denominator" in all of the works it produces. That is, it must comply with the strictest law in all of the circuits out of a fear that some of its publications will be distributed there.

Thus, it is imperative that copyright laws throughout the United States be uniform, and that aberrant rulings be corrected quickly.

Second, writing, publishing, and broadcasting serve the highest values underlying the First Amendment. "The fortunes of the law of copyright have always been closely

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derivative works under terms of grant from author; petitioner alleged no conflict at all); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (holding that video tape recorder manufacturers are not liable for contributory infringement based on taping by users of the recorders; petitioner alleged only a conflict in principle with a decision of Court of Claims).

connected with freedom of expression . . . ." *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 n.12 (1984) (citation and quotation marks omitted). Delay in resolving important copyright issues – or allowing individual courts of appeal to craft rules different from those uniformly accepted across the country – undermines vital First Amendment interests. Prompt correction of the error committed in the decision below is important for this reason as well.

II. GRANTING THE PETITION WILL HAVE THE ADDED BENEFIT OF CLARIFYING THE STATUS OF THE COPYRIGHT ESTOPPEL DOCTRINE.

Though not strictly raised by the question presented, granting the Petition will also help clarify the status of the doctrine of copyright estoppel, which the decision below appears to have rejected. "Under the doctrine of copyright estoppel, once a plaintiff's work has been held out to the public as factual the author-plaintiff cannot then claim that the book is, in actuality, fiction and thus entitled to the higher protection allowed to fictional works." *Houts v. Universal City Studios, Inc.* 603 F. Supp. 26, 28 (C.D. Cal. 1984); *accord Oliver v. St. Germain Found.*, 41 F. Supp. 296, 299 (S.D.Cal. 1941); 1 M. Nimmer & D. Nimmer, *Copyright* § 2.11[C] (2000) (hereinafter "Nimmer") ("[O]ne who represents his work to be completely factual may not in a subsequent infringement action prove that part of the work was fictional and therefore protectible."). The rationale for this doctrine is straightforward: If an author were allowed to change positions and assert that the work was actually fiction, it "'would unduly chill authors seeking to write about historical issues or events.'" Nimmer § 2.11[C] (quoting *Marshall v. Yates*, 223 U.S.P.Q. 453, 455 n.3 (C.D. Cal.

1983)). The doctrine has been adopted by the Second and Seventh Circuits as well as numerous lower courts.[5]

A corollary of this doctrine, specifically established in the lower courts, is that where an author claims his or her work is completely factual and then reports therein what purport to be the verbatim statements of others, the "author may not claim copyright in [such] statements." *Williamson v. Pearson Educ., Inc.*, 60 U.S.P.Q.2d 1723, 1726 (S.D.N.Y. 2001) (denying copyright protection for quotations attributed to General Patton in factual work).[6] Such statements are bare facts which cannot be copyrighted.

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[5] *See Arica Inst., Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992); *Nash v. CBS, Inc.*, 899 F.2d 1537 (7th Cir. 1990); *see also Nester's Map & Guide Corp. v. Hagstrom Map Co.*, 796 F. Supp. 729, 733 (E.D.N.Y. 1992) ("copyright estoppel" bars plaintiff from using "'false facts'" in allegedly factual map as basis for infringement claim); *Oliver*, 41 F. Supp. at 299; *Marshall v. Yates*, 223 U.S.P.Q. 453, 456 (C.D. Cal. 1983); *Mosley v. Follett*, 209 U.S.P.Q. 1109, 1112-13 (S.D.N.Y. 1980); *Greenbie v. Noble*, 151 F. Supp. 45, 67 (S.D.N.Y. 1957); *Davies v. Bowes*, 209 F. 53, 55 (S.D.N.Y. 1913), *aff'd* 219 F. 178 (2d Cir. 1914); *Skinder-Strauss Assocs. v. Massachusetts Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 675-76 (D. Mass. 1995) ("If copying true facts is permissible, it is immaterial whether [the defendant] copied false facts or 'seeds' [referring to fictitious attorney names inserted into a legal directory for the express purpose of detecting copying]."); *Huie v. NBC*, 184 F. Supp. 198, 199-200 (S.D.N.Y. 1960) ("plaintiff represented his story to be a true story [and thus] is estopped to say that the episodes are not historical"); *Lake v. CBS, Inc.*, 140 F. Supp. 707, 708 (S.D. Cal. 1956).

[6] *See also Russell v. Turnbaugh*, 18 U.S.P.Q.2d 1948, 1951 (D. Colo. 1991) ("an author may not claim copyright violations in statements made by others and reported or quoted in their work"); *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 148 (D.D.C. 1980) ("The author of a factual work may not, without an assignment of copyright, claim copyright in statements made by others and reported in the work since the author may not claim originality as to those statements."); *Rokeach v. Avco Embassy Pictures Corp.*, 197 U.S.P.Q. 155, 161 (S.D.N.Y. 1978) ("In no real sense can [the plaintiff] claim to have created these statements" that he reported in his factual work.)

The Tenth Circuit's opinion has sown significant confusion by effectively rejecting copyright estoppel in this context. The decision acknowledges that Respondent Jacobsen's work, *Who Refused to Die*, is a factual account: a "personal memoir" that in "gripping detail . . . recounts Dr. Jacobsen's survival of the Bataan Death March and subsequent years of imprisonment and torture in various work camps." App. 1a. Indeed, it was undisputed that Jacobsen held out his memoirs to petitioner Hughes as entirely factual, without any fictional elements. *See* C.A. Appellants' App. 264 (undisputed fact on summary judgment: "everything that is written in all of the versions [of *Who Refused to Die*] is all fact"); *see id.* at 10, 12, 316, 809; C.A. Appellees' Supp. App. 36. Accordingly, absent "bodily appropriat[ion] [of Jacobsen's] expression," *Hoehling*, 618 F.2d at 980, under the doctrine of copyright estoppel subsequent authors would be free to use facts from Jacobsen's memoirs in their own works without fear of subsequent liability. Those facts, moreover, would include a statement made by someone else that the memoir reports verbatim.

The Tenth Circuit's decision nevertheless holds that petitioners' copying of parts of a statement recounted in the memoirs raises a triable issue of fact as to whether elements of the statement were actually the author's original expression and thus protected notwithstanding his earlier representation to the contrary. App. 12a-14a.[7] The court reasoned:

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[7] The court quoted the relevant passage from Petitioner Hughes' work, italicizing words that are identical in the two works:

> "This time it was Potts who walked on ahead. He was carrying a souvenir sword of his own. When he stepped onto the deck, he shouted, "We need to talk," and he slammed his sword into the deck, sticking it up by its point. . . . '*Listen* to me *you guys*,' Potts went on. '*General* Douglas *MacArthur* has authorized us *to use any means* we find *necessary* to reach American troops. *We*'re *going to* cross *this bay with you or without you. If you want to take us across and get*

> We agree quotations may be freely copied if the quotation is recorded contemporaneously or taken directly from a written source . . . . Dr. Jacobsen did not, however, contemporaneously record the quotations or copy them from a written source. For this reason, a trier of fact might conclude the material in quotation marks in *Who Refused to Die* was original expression rather than the actual words used. Dr. Jacobsen may have enclosed the material in quotations merely to allow him to speak in the voice of a third party while recording his story. Because the issue of whether the dialogue in *Who Refused to Die* is original expression or fact turns, at least in part, on additional evidence to be presented at trial, the question should be determined by the trier of fact rather than the court.

Id. at 13a-14a.

By creating a triable issue regarding the originality of a verbatim report of a dialogue, the Tenth Circuit appears to have repudiated the doctrine of copyright estoppel. The decision below is thus in serious tension with decisions of the Second and Seventh Circuits and the various district courts mentioned above.

Granting the Petition will provide the Court with an opportunity to remove the cloud that the Tenth Circuit's opinion has left over this important doctrine. If the Court reverses the Tenth Circuit on the basis of the issue presented in the petition, there will be no need to address the copyright estoppel doctrine; the Tenth Circuit's apparent rejection of that doctrine will be moot. On the other hand, if the Court ultimately agrees with the Tenth Circuit's resolution of the issue presented, the Court will then have the option of addressing the copyright estoppel doctrine and thereby

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> *paid for your troubles, fine. If you don't, get off the ship, and we'll take* her across ourselves.'"

App. 13a (emphasis in original).

rectifying that important aspect of the Tenth Circuit's decision.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

VON G. KEETCH*
BERNIE S. BROADBENT
ALEXANDER DUSHKU
KIRTON & MCCONKIE
A PROFESSIONAL CORPORATION
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
(801) 328-3600

CARTER G. PHILLIPS
GENE C. SCHAERR
SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, D.C. 20005
(202) 736-8000

Counsel for Amici Curiae

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* Counsel of Record